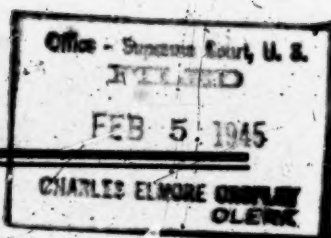




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IN THE

**Supreme Court of the United States**

October Term, 1944.

No. 486.

**THE HOOVER COMPANY,**

*Petitioner,*

vs.

**CONWAY P. COE, Commissioner of Patents,**

*Respondent.*

**BRIEF OF PETITIONER.**

✓ **WILLIAM D. SELLERS,**

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*Attorneys for Petitioner.*

✓ **WILLIAM S. HODGES,**

*Of Counsel.*



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IN THE  
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October Term, 1944

No. 486.

**THE HOOVER COMPANY,**

*Petitioner,*

vs.

**CONWAY P. COE, Commissioner of Patents,**  
*Respondent.*

**BRIEF OF PETITIONERS.**

The opinion of the Court of Appeals for the District of Columbia is reported at 144 F. (2d) 514, 62 U. S. P. Q. 115, and appears herewith in the record (R. 140).

The District Court did not enter an opinion, but its findings of fact and conclusions of law appear in the record (R. 19).

## Jurisdiction.

Writ of certiorari issued to the Court of Appeals for the District of Columbia.

The grounds on which the jurisdiction of this Court was invoked follow:

(1) The statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code, 28 U. S. C. 347, as amended by the Act of February 13, 1925.

(2) The judgment of the United States Court of Appeals for the District of Columbia was entered on July 10, 1944.

(3) The foregoing judgment was entered on appeal from a judgment by the District Court for the District of Columbia in a suit in equity brought under the Revised Statutes, Section 4915, 35 U. S. C. 63, as amended by Act of August 5, 1939, to have remedy from the refusal of the Board of Appeals of the Patent Office to grant a patent to Petitioner as assignee of reissue patent application Serial No. 373,970, filed by Curtis C. Coons.

(4) The real question before this Court is the construction of a United States Statute (R. S. 4915). It has been held by this Court in *American Steel Foundries v. Robertson*, 262 U. S. 209, and *United States ex rel Baldwin Company v. Robertson*, 265 U. S. 168, that this Court does have jurisdiction in such cases.

This Court has taken jurisdiction of *ex parte* 4915 actions without question in the following cases: *Gandy v. Marble*, 122 U. S. 432, and *Butterworth v. Hill*, 114 U. S. 128.

Furthermore, that an *ex parte* 4915 action is judicial in character is evidenced by the following decisions of this Court: *Tutun v. United States*, 270 U. S. 568, 46 S. Ct. 425, *Johannessen v. United States*, 225 U. S. 227, 32 S. Ct. 613, *Butterworth v. Hoe*, 112 U. S. 50, *Frasch v. Moore*, 211 U. S. 1, *Hull v. Commissioner of Patents*, 9 MacA. 90, *United States ex rel Bernardin v. Duell*, 172 U. S. 576. See also a decision by the Sixth Circuit Court of Appeals in *Cleveland Trust Company v. Berry*, 99 F. (2d) 517.

#### Statement of the Case.

On January 10, 1941, Curtis C. Coons, petitioner's assignor, filed an application for reissue patent in the United States Patent Office of his original patent 2,178,870 which had been granted November 7, 1939, upon an original application filed August 8, 1936. The invention of the application comprises a refrigeration system.

The Examiner in the Patent Office finally rejected Claims 15, 16, 38 and 39 (R. 115), stating that the claims were "rejected as not reading on applicant's disclosure and this rejection is Made Final." Upon appeal the Board of Appeals of the United States Patent Office affirmed the Examiner's decision (R. 131).

Claims 16, 38 and 39, which were finally rejected by the Examiner, originated in the Coons' reissue application. Claim 15 was copied from the patent to Bergholm 2,201,362 (R. 134) for purposes of interference to determine priority of invention.

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The *Bergholm* patent 2,201,362 (R. 134) was filed in the United States Patent Office on November 20, 1937, and issued as a patent on May 21, 1940, being assigned to Servel, Inc., a corporation of Delaware. Bergholm's earliest date in the record is over one year later than petitioner's.

Petitioner filed its complaint (R. 3) in the United States District Court for the District of Columbia under the provisions of Revised Statutes, 4915, U. S. C., Title 35, Section 63 (Appendix, p. 20), praying for the relief provided by Section 4915, R. S. The District Court in a decree (R. 14) dated June 21, 1943, dismissed the complaint, the decision being based upon the merits of petitioner's case. The only question considered by the District Court was the question of whether or not the claims were readable upon the Coons application construction.

Appeal (R. 15) was taken from the decision of the District Court for the District of Columbia to the Court of Appeals for the District of Columbia which, in a decision (R. 140) dated July 10, 1944, affirmed the judgment of the lower Court without touching the merits, the decision being based solely upon the grounds that "the District Court had no jurisdiction over this suit."

#### **Specification of Errors.**

The errors which the petitioner urges are that the Court of Appeals for the District of Columbia erred:

1. In affirming the dismissal of Petitioner's Bill of Complaint and upon the grounds that the District Court had no jurisdiction under the provisions of Section 4915 R. S.
2. In holding, contrary to past practice, that Petitioner was not entitled to relief under the provisions of Section

4915 R. S. after having been refused a patent by the Board of Appeals and because he had not established priority of invention over another claiming the same invention, the Patent Office having refused to set up an interference to determine the question of priority after having been requested to do so by Petitioner and in conformance with its long-established practice.

3. In holding, contrary to past practice, that Petitioner is not entitled to relief under Section 4915, R. S. because a third party, who was not an adverse party to Petitioner in the Patent Office, was not made a party defendant to the action in addition to the Commissioner of Patents, there having been a refusal to grant the patent to Petitioner by the Board of Appeals of the Patent Office but no interference or decision by the board of interference examiners.

4. In refusing to decide the case upon its merits and instead dismissing upon the grounds of lack of jurisdiction.

### **QUESTIONS BEFORE THE COURT.**

The questions raised by the decision below involving the construction of the patent laws are:

#### **Question 1.**

Does Section 4915 R. S. (U. S. C., Title 35, Sec. 63) convey jurisdiction upon the District Court for the District of Columbia of an action begun by bill in equity by an applicant who has been refused a patent by the Board of Appeals where, if the Court holds for the applicant, further prosecution in the Patent Office may take place in "complying with the requirements of law"? (R. S. 4915 at Appendix, p. 20.)

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**Question 2.**

In Section 4915 R. S. (U.S.C., Title:35, Sec. 63), which provides "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant . . . may have remedy by bill in equity . . .," does the word "or" mean "and," whereby action by both boards must precede applicant's right to the remedy provided?

**Question 3.**

In an action brought by an applicant for a patent under Section 4915, R. S. (U.S.C., Title 35, Sec. 63) against the Commissioner of Patents as defendant, and following a refusal by the Board of Appeals to grant the patent, is a third party claiming the same invention a necessary party when not involved in interference with the applicant to determine priority of invention but where an interference may be set up by the Patent Office if the Court holds for the applicant?

**SUMMARY OF ARGUMENT.**

1. Section 4915 R. S. Conveys Jurisdiction Upon The District Court For The District Of Columbia Of An Action Begun By Bill In Equity By An Applicant Who Has Been Refused A Patent By The Board Of Appeals And The Fact That Further Prosecution May Take Place In The Patent Office In "Complying With The Requirements Of Law," Should The Court Hold For The Applicant, Does Not Deprive The Court Of Its Jurisdiction.

(A. THE DECISION BELOW IS CLEARLY CONTRARY TO THE CONGRESSIONAL PURPOSE IN VIEW OF THE HISTORY OF THE REMEDY NOW PROVIDED BY SECTION 4915 R. S.

B. THE LAW HAS ALWAYS BEEN SO UNDERSTOOD BY THE COURTS AND THIS INTERPRETATION IS CONSISTENT WITH COORDINATE STATUTES.

a. *The Court's Mandate In An R. S. 4915 Suit Does Not Require Commissioner To Ignore "Other Requirements Of The Law."*

b. *The Refusal Of A Patent Upon Any Grounds Is Reviewable Under Section 4915 R. S.*

c. *The Remedy Under Section 4915 R. S. Is Co-Extensive With The Remedy Under Section 4911 R. S.*

d. *The Decisions Cited By The Court Below Do Not Support The Holding.*

C. THE DECISION OF THE COURT OF APPEALS IS INCONSISTENT WITH THE ACTUAL WORKING OF THE PATENT SYSTEM AND WITH THE RULES OF PRACTICE IN THE UNITED STATES PATENT OFFICE.

D. UNDER THE DECISION BELOW IT IS IMPOSSIBLE, FIRST, FOR A COURT EVER TO DETERMINE ITS JURISDICTION CONCLUSIVELY AND SECOND, FOR AN APPLICANT TO DETERMINE WHETHER BY BRINGING AN ACTION UNDER SECTION 4915 R. S. HE MAY NOT EFFECT THE ABANDONMENT OF HIS APPLICATION.

2. The Provision In Section 4915 R. S. Of A "Remedy By Bill In Equity" . . . "Whenever A Patent On Application Is Refused By The Board Of Appeals Or Whenever Any Applicant Is Dissatisfied With The Decision Of The Board Of Interference Examiners," Provides For Remedies Under Two Separate Conditions.

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3. In An Ex Parte Action Brought Under Section 4915 R. S. By An Applicant After Refusal Of A Patent By The Board Of Appeals, A Third Party Claiming The Same Invention Is Not A Necessary Party Where No Interference Between Applicant And The Third Party Was Instituted By The Patent Office.

### ARGUMENT.

1. Section 4915 R. S. Conveys Jurisdiction Upon The District Court For The District Of Columbia Of An Action Begun By Bill In Equity By An Applicant Who Has Been Refused A Patent By The Board Of Appeals And The Fact That Further Prosecution May Take Place In The Patent Office In "Complying With The Requirements Of Law," Should The Court Hold For The Applicant, Does Not Deprive The Court Of Its Jurisdiction.

1A. THE DECISION BELOW IS CLEARLY CONTRARY TO THE CONGRESSIONAL PURPOSE IN VIEW OF THE HISTORY OF THE REMEDY NOW PROVIDED BY SECTION 4915 R. S.

The first legislation providing a defeated patent applicant with the right to file a bill in equity was enacted in 1836. The remedy has received a great deal of attention since. Because of the many enactments, and in order to present a clear history, charts are to be found on the pages immediately following which show the remedial steps followed by the patent applicant at various periods.

At the outset it may be well to state that an ex parte case is one in which only the applicant and the Commissioner of

Patents are parties. An inter partes case is one in which an interference has been set up in the Patent Office involving two or more patent applicants, or an applicant and a patentee. Only the Commissioner of Patents and adverse parties to an interference set up in the Patent Office can be made adverse parties in a suit brought under Section 4915 R. S. (Appendix, p. 20) (*Dracket Co. v. Chamberlain Co.*, 10 F. S. 85F, affirmed 81 F. (2d) 866; *Fessenden v. G. E.*, 10 F. S. 846).

While we are here solely interested in the ex parte case, both types of cases have been shown in the charts for their history is closely related. The charts now follow, being arranged chronologically:

## CHART 1.

Act of 1836 (Appendix, p. 1)

5 Statutes at Large, 117

Approved July 4, 1836

Repealed July 8, 1870,

16 Statutes at Large,

Chapter 230, Section 111, p. 216

ex parte

inter partes

Sec.

Sec.

7

PATENT OFFICE

8

PATENT OFFICE

Sec.

Sec.

7

APPOINTED BD.  
OF EXAMINERS

8

APPOINTED BD.  
OF EXAMINERS

Sec. 16

&amp; BILL IN EQUITY

Sec. 8

Comment: Equity suit provided in inter partes cases only.

Sec. 16 (Appendix, p. 4)

"Whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent . . . may have remedy by bill in equity . . ."

## CHART 2.

Act of 1839 (Appendix, p. 5)

5 Statutes at Large, 353

Approved March 3, 1839

Repealed July 8, 1870,

16 Statutes at Large,

( Chapter 230, Section 111, p. 216.

ex parte

inter partes

Sec.

7 of

1836

PATENT OFFICE

Sec.

8 of

1836

PATENT OFFICE

Sec.

11

CHIEF JUSTICE  
OF DIST. OF  
COLUMBIA

Sec.

11

CHIEF JUSTICE  
OF DIST. OF  
COLUMBIA

Sec.

10

BILL IN EQUITY

Sec.

10

BILL IN EQUITY

Comment: An appeal in the nature of the appeal now provided by Section 4911 R. S. provided. \* \* \* An equity action possible in both types of cases.

Sec. 10 (Appendix, p. 3)

..... the provisions of the Sixteenth Section of the before-recited act (Act of 1836) shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia." (Parenthetical matter and italics added.)

Act of 1852

10 Statutes at Large, 75 (Walker p. 895),

Approved August 30, 1852

Repealed July 8, 1870,

16 Statutes at Large,

Chapter 230, Section 111, p. 216.

Section 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That appeals provided for in the eleventh section of the act entitled "An Act in addition to an act to promote the progress of the useful arts, approved March the third, eighteen hundred and thirty-nine, may also be made to either of the assistant judges of the Circuit Court of the District of Columbia, and all the powers, duties and responsibilities imposed by the aforesaid act, and conferred upon the chief judge, are hereby imposed and conferred upon each of the said assistant judges."

## CHART 3.

Consolidated Patent Act of 1870 (Appendix, p. 6)

16 Statutes at Large, 198

Approved July 8, 1870

Repealed June 22, 1874

Revised Statutes, Title LXXIV

ex parte		inter partes	
Sec. 41	PATENT OFFICE EXAMINER	Sec. 42	PATENT OFFICE EXAMINER
Sec. 46	BD. OF EXAMINERS IN-CHIEF	Sec. 46	BD. OF EXAMINERS IN-CHIEF
Sec. 47	COMMISSIONER	Sec. 47	COMMISSIONER
Sec. 48	SUPREME COURT OF DIST. OF COLUMBIA		
Sec. 52	BILL IN EQUITY	Sec. 52	BILL IN EQUITY

Comment: Appeal lies when "any of the claims" are rejected and the equity action lies when the patent is refused "for any reason whatever."

Appeals in inter partes cases dropped.

Appeal in ex parte cases now goes to Supreme Court of the District of Columbia.

## Sec. 46 (Appendix, p. 7)

every applicant for patent, *any* of the claims of which have been twice rejected *may appeal* to the board of examiners-in-chief *(Italics added.)*

## Sec. 48 (Appendix, p. 7)

That if such party, except a party to an interference, is dissatisfied *may appeal to the Supreme Court of the District of Columbia,*

## Sec. 52 (Appendix, p. 7)

whenever a patent on application is refused, *for any reason whatever*, either by the Commissioner or by the Supreme Court of the District of Columbia, the applicant may have remedy *by bill in equity:* (Italics added.)

## CHART 4.

Revised Statutes in 1874 (Appendix; p. 8)  
 Approved June 22, 1874

ex parte

inter partes

PATENT OFFICE  
 EXAMINER

PATENT OFFICE  
 EXAMINER

Sec. 4909 BD. OF EXAMIN- Sec. 4909 BD. OF EXAMIN-  
 R. S. ERS-IN-CHIEF R. S. ERS-IN-CHIEF

Sec. 4910 COMMISSIONER Sec. 4910 COMMISSIONER  
 R. S. R. S.

Sec. 4911 SUPREME CT.  
 R. S. OF DIST. OF  
 COLUMBIA

Sec. 4915 BILL IN EQUITY Sec. 4915 BILL IN EQUITY  
 R. S. R. S.

Comment: Procedure identical to that under 1870 Act.  
 Wording changed slightly in revision. Equity action lies  
 when patent is "refused" which provision is equal in  
 breadth to the provision of the 1870 Act, that is, "refused,  
 for any reason whatever."

Sec. 4909 (Appendix, p. 8)

"Every applicant for a patent \* \* \* any of the claims of which have been twice rejected, and every party to an interference, may appeal \* \* \* to the board of examiners-in-chief;" (Italics added.)

Sec. 4910 (Appendix, p. 8)

"If such party is dissatisfied \* \* \* may \* \* \* appeal to the Commissioner \* \* \* (Italics added.)"

Sec. 4911 (Appendix, p. 8)

"If such party, except a party to an interference, is dissatisfied \* \* \* may appeal to the Supreme Court of the District of Columbia \* \* \* (Italics added.)"

Sec. 4915 (Appendix, p. 9)

"Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia \* \* \* the applicant may have remedy by bill in equity \* \* \*"

## CHART 6.

(Judiciary Act of 1893 (Appendix, p. 9)  
Approved February 9, 1893

27 Statutes at Large, page 434, chapter 74

ex parte  
PATENT OFFICE  
EXAMINER

inter partes  
PATENT OFFICE  
EXAMINER

Sec. 4909 BD. OF EXAMIN-  
R. S. ERS IN CHIEF

Sec. 4909 BD. OF EXAMIN-  
R. S. ERS IN CHIEF

Sec. 4910 COMMISSIONER  
R. S.

Sec. 4910 COMMISSIONER  
R. S.

Sec. 9 CT. OF APPEALS  
Act of OF DIST. OF  
1893 COLUMBIA

Sec. 9 CT. OF APPEALS  
Act of OF DIST. OF  
1893 COLUMBIA

Sec. 4915 BILL IN EQUITY  
R. S.

Sec. 4915 BILL IN EQUITY  
R. S.

Comment: Appeals from decisions of Commissioner are possible in inter partes cases. All appeals are heard by Court of Appeals of the District of Columbia instead of the Supreme Court of the District of Columbia.

Sec. 9, Act of 1893 (Appendix, p. 9)

"That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia \* \* \* is hereby vested in the Court of Appeals \* \* \*; and in addition any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

## CHART 7.

Revised Statutes after Act of 1927 (Appendix, p. 9)  
(Chapter 273, Secs. 8, 11, 44, Stat. 1336)

Approved January 4, 1927.

The change which the Act of 1927 effected in both ex parte and inter partes is well evidenced by the chart found on page 3 of Report No. 1889, 69th Congress, 2d Session, made by the Committee on Patents with respect to H.R. 13487. That chart is here copied:

(Before Act of 1927)  
**PRESENT COURSE OF  
PATENT APPEALS**

**EXAMINER**

**APPEAL TO BOARD OF  
EXAMINERS-IN-CHIEF**

**APPEAL TO COMMISSIONER OF PATENTS**

**APPEAL TO COURT OF  
APPEALS, D. C.**

**BILL IN EQUITY  
SEC. 4915.**

**APPEAL TO COURT  
OF APPEALS**

(After Act of 1927)  
**PROPOSED COURSE OF  
PATENT APPEALS**

**EXAMINER**

**APPEAL TO NEW BOARD  
OF APPEALS IN  
PATENT OFFICE**

**APPEAL TO COURT  
OF APPEALS  
D. C.** **BILL IN  
EQUITY  
SEC. 4915**

**APPEAL TO COURT  
OF APPEALS**

Comment: The procedure in ex parte and inter partes cases is identical. The present course is that illustrated as existing after the Judiciary Act of 1893. The direct appeal to the Court of Appeals from the Board of Appeals was changed to the Court of Customs and Patent Appeals by the Act of March 2, 1929, c. 488, Sec. 3, 45 Stat. 1476. (Appendix p. 13.)

It is seen that continuously since 1836 the law has provided a remedy by bill in equity to the dissatisfied patent applicant. In 1836 the remedy was limited to inter partes cases but in 1839 ex parte and inter partes cases were placed upon an equal footing and a bill in equity could be filed "where patents are refused for any reason whatever." In the subsequent reenactment in the Consolidated Patent Act of 1870 the same wording was used only to be replaced four years later by the revisers of the statutes by a simpler, shorter wording. The Revised Statutes omitted the words "for any reason whatever" and provided the remedy "Whenever a patent on application is refused." It must be presumed that the revisers of the Statutes recognized the equivalence of the expressions. If a bill can be filed "when-ever" a patent is "refused" that right is not enlarged by adding "for any reason whatever." Section 4915 R. S. (Appendix, p. 20) today reads, and at the time the bill in this case was filed read, "Whenever a patent on application is refused."

It is also important to note that the right of appeal through successive steps to the Supreme Court of the District of Columbia was granted by the Act of 1870, Secs. 46, 47 and 48 (Appendix p. 7) where "any of the claims" of the application were twice rejected. It was not necessary that all the claims be rejected but only that at least one of them be twice, that is finally, rejected. This same provision is found today in Section 4909 R. S. (Appendix p. 18) and petitioner's claims were twice rejected (R. 113) by the Examiner.

From 1839 to 1927 an applicant, having "any" claim twice rejected, could take an ex parte appeal from the Patent Office to a court and thereafter, if still refused a patent containing the desired claim or claims, bring a bill

in equity. The equity suit directly followed the appeal and a careful study of the cases and of the statutes fails to disclose a single indication that an applicant having the right to appeal did not likewise have the right, if unsuccessful in the appeal, to proceed to the next succeeding step, the equity action.

In part 1B of this brief the decisions clearly establishing the equal scope of the appeal and the 4915 action are discussed.

Congress intended the Patent Act of 1927 (Appendix p. 9) to make the appeal under Section 4911 R. S. and the bill in equity under Section 4915 R. S. optional and alternate remedies. The statements found in the reports of the Committees on Patents in the House and in the Senate should be most persuasive.

As illustrated *supra* in Chart 7 prior to the Act of 1927 the remedy by appeal and the remedy by bill in equity were successive. Clearly, when arranged in successive steps the equity action must have had a scope at least equal to the scope of the appeal action or every unsuccessful appeal could not have been carried forward into a 4915 action. By the 1927 Act the appeal and the bill in equity are rearranged into optional, alternate, mutually exclusive remedies. No change in scope of either action was indicated in any way.

The favorable report of the House Committee on Patents, Report No. 1889, 69th Congress, 2d Session, as to H.R. 13487, rendered prior to the adoption of the 1927 Patent Act, reads as follows at page 2:

"The proposed bill has for its object the simplification and reduction of the number of appeals. It provides for the creation of a new Board of Appeals in the Patent Office, consisting of the examiners in chief,

the commissioner and assistant commissioners. Applicants may appeal direct from the examiner to this new board of appeals, thus cutting out one appeal in the Patent Office. *It then gives the option to the losing party to appeal to the Circuit Court of Appeals of the District of Columbia, or to file a bill in equity under section 4915.* If the appeal goes to the Court of Appeals and is defeated, the applicant's right to appeal is ended. If on the other hand a bill in equity, if filed, under section 4915, the losing party has preserved his right to again appeal to the Circuit Court of Appeals.

"It will thus be seen that under the proposed procedure *the defeated party has all the rights and remedies that he had under the old procedure*, but the appeals are reduced so that there are but three appeals." (Italics supplied).

The favorable report of the Senate Committee on Patents on S. 4812, corresponding to H.R. 13487, was identified as Report No. 1313, 69th Congress, 2d Session. This report, also made prior to the adoption of the Act of 1927, contained a similar indication of intent at page 4 as follows:

"Section 8 rewrites Section 4911 of the Revised Statutes so as to provide for a simplified appeal from the Patent Office. Under present statutes an applicant whose case has been rejected or a losing party in an interference may appeal to the Court of Appeals of the District of Columbia and then if he is dissatisfied he may start proceedings de novo by filing a bill in equity in a United States district court, under Section 4915, and from the decision of that court he may appeal to the court of appeals. This procedure makes for very vexatious delays and the *object of the present bill is to permit one to have the decision of the Patent Office reviewed either by the court of appeals or by filing a bill in equity, but not both.* Therefore section 4911 has been rewritten to provide that an applicant may appeal to the court of appeals, but if he does so he

waives his right to proceed under Section 4915. Nevertheless, in order that the other party may not be deprived from his remedy under section 4915, it provides that he may serve notice upon the one who is taking the appeal to the court of appeals which would result in having the case transferred to the United States district court under section 4915." (Italics supplied).

Both the Senate and the House reports contained charts like Chart 7 *supra*.

The testimony before the Senate Committee on Patents on S. 4812 held December 21, 1926 prior to the adoption of the Patent Act of 1927, clearly brought out that those supporting the bill understood that under the new law the remedies of appeal and bill in equity would be alternate and optional.

The following is found on page 10 of the hearing on S. 4812, December 21, 1926:

Commissioner of Patents Robertson: \* \* \* "So we have struck the happy medium of permitting him to take one of these courses, but not both."

Senator Stewart: \* \* \* "That is the principle of election of remedies."

Commissioner Robertson: "Yes, sir. And the bar seems to be behind that. In fact it is practically unanimous. Mr. Fish, of Boston, who objects to two features of the bill but approves the bill generally, and I think agrees with us that that is a very good provision."

The following appears on page 8 of the report of the hearing:

Senator Shipstead: "Then you can go either to an equity court or a court of law?"

Commissioner Robertson: "One is a straight appeal from the Patent Office to the court, and the other is a proceeding in equity."

Mr. A. C. Paul, then chairman of the American Bar Association committee, in discussing a letter sent by Mr. Fish, distinguished patent lawyer and then president of the Boston Patent Law Association, said: (p. 11).

"This bill changes that so that if they go to the court of appeals they waive the right to file a bill in equity; and if they file a bill in equity, they cannot go to the Court of Appeals, because they have the alternate remedy."

It is believed that the history of the legislation clearly supports the long-accepted view that appeals under Section 4911 R. S. and bills in equity under Section 4915 R. S. are remedies of the same breadth. If the court below was correct in believing that an appeal under Section 4911 R. S. was the proper remedy, then it should have held that the bill in equity filed under Section 4915 R. S. was suitable.

**THE LAW HAS ALWAYS BEEN SO UNDERSTOOD BY THE COURTS AND THIS INTERPRETATION IS CONSISTENT WITH COORDINATE STATUTES.**

The decision of the court below, written by Justice Thurman Arnold, reverses the law as it has been understood and applied for over one hundred years. In the absence of any compelling necessity that decision does violence to the clear unambiguous language of the statute, ignores the clear implication of coordinate statutes, and creates confusion in the administration of the patent law in the United States Patent Office.

Section 4915 R. S. clearly gives an applicant the right to seek relief from the refusal of a patent by the Patent Office Board of Appeals by filing a bill in equity. *Gandy v. Marble*, 1887, 122 U. S. 432; *U. S. ex el Baldwin v. Robertson*, 265 U. S. 168; *Bakelite Corp. v. Nat'l. Auline, etc. Co.*, 83 F. (2d) 176.

Petitioner was refused a patent containing Claims 15, 16, 38 and 39 and was entitled to bring an action in the District Court for the District of Columbia against the Commissioner of Patents. The Court of Appeals below was of the opinion that the present case was not covered by the statute even though it fell within the precise wording thereof because of certain facts which appeared in the record of the case but *which facts might be true in any case ever brought under the statute*. These facts were that the record showed that further prosecution might be necessary in the Patent Office should the Court's decision be in favor of the applicant.

*1Ba. The Court's Mandate In An R. S. 4915 Suit Does Not Require Commissioner To Ignore "Other Requirements of Law."*

The statute itself provides that after a favorable decision in the action brought under Sec. 4915 R. S. (Appendix, p. 20) and in which the court "authorizes" the Commissioner of Patents to issue a patent, an applicant is only entitled to a patent upon "filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law." The provision "otherwise complying with the requirements of law" clearly envisages the duty residing on the applicant of successfully overcoming any legal barrier raised by the Commissioner to the grant of a patent as "authorized" after the return of the application to the Patent Office; and the Courts have so stated.

In *Gandy v. Marble*, 1887, 122 U. S. 432, this Court said:

"All that the court which takes cognizance of the bill in equity, under Section 4915, is authorized to do is to adjudge whether or not 'The applicant is entitled, according to law, to receive a patent' and after an adjudication in his favor to that effect, the Commis-

sioner is not authorized to issue a patent unless the applicant otherwise complies with the requirements of law."

The same language "otherwise complying with the requirements of law" has been present in the statute since 1874 and prior to that time (1836-1874) the equivalent wording "otherwise complying with the requisitions of law" was used. Accordingly, the construction placed upon the words in *Gandy v. Marble*, *supra*, applies today.

In *Cleveland Trust Company v. Nelson*, D. C. E. D. Mich., 1931, 51 F. (2d) 276, 278, affirmed in *Cleveland Trust Co. v. Berry*, C. C. A. 6, 99 F. (2d) 517, the court said:

"\* \* \*. Granted that the patent will not issue to the successful party until he has complied with the requirements of law, there is nothing in that provision that takes the proceeding outside of the class of cases or controversies. \* \* \*"

In *Philadelphia Storage Battery Co. v. Zenith Radio Corp.*, C. C. A. 7th, (1941), 117 F. (2d) 642, 645, the Court said:

"We do not understand that section 4915 of the Revised Statutes contemplates that the court shall direct the Commissioner to issue a patent. This must be true because there are other matters which the department must decide favorably to Jacke's assignee before a patent can issue to it. The statute which authorizes the issuance of patents must be complied with in every respect, and we have no power under section 4915 to restrict those requirements."

In an action under 4915 R. S. it is not necessary that the court's mandate compel the Commissioner to grant the patent.

In *Monopower v. Coc*, D. C. D. C. 33 F. S. 934, (1940) the court said:

"My conclusion is that, unless, by appropriate proceedings in the Patent Office, it is determined that Roy E. Milliken and Word Milliken have priority of invention with respect to the claims here in controversy, the plaintiffs are entitled, according to law, to receive a patent for the inventions as specified in such claims, and that the plaintiffs are entitled to the relief sought by the complaint herein."

In *Vermont Farm Machinery Co. v. Marble*, 20 F. 117, it was held that the fact that the Commissioner was outside the court's jurisdiction and therefore could not be compelled to perform the court's mandate would not defeat the court's jurisdiction.

In *Pitman v. Coc*, 62 App. D. C. 365, 68 F. (2d) 412, (1933) the Court of Appeals, D. C., said:

"We can see no reason for holding that such a remedy (review of requirement for division) is confined to a review by the appellate court of the decisions of the Patent Office, and is denied in proceedings brought by the applicant for review in a court of equity. It is true that the remedies are diverse; and nevertheless the substantive rights of the applicants, which are the basis alike of the appeal and bill in equity, are identical. There is no reason to believe that Congress intended that any remedy which might be obtained by appeal should be more extensive or complete than that allowed by bill in equity. \* \* \* (Parenthetical matter added.)"

In *Baldwin v. Robertson*, 265 U. S. 168, the action was a bill for an injunction under 4915 R. S. and this court held that the District Court had jurisdiction. Thus the court's mandate under 4915 R. S. does not compel the Commissioner to issue a patent without further action.

It is the usual practice in the Patent Office to consider the "other requirements of the law" when a case is returned to the Patent Office after a favorable decree under

Section 4915 R. S. Examples of this practice are: *Gold v. Newton*, 254 F. 824; *Radlke Patents Corp. v. Coe*, 74 App. D. C. 251; 122 F. (2d) 937; *Tully v. Robertson*, 19 F. (2d) 954. Rule 96, Rules of Practice of the Patent Office (Appendix, p. 25), states:

"After judgment of priority the application of any party may be held for revision and restriction, subject to interference with other applications."

The same is true after a case is allowed *ex parte*. The above rule applies whether the judgment is by the examiner or the Court under Section 4915 R. S. Subsequent Patent Office prosecution could comprise a previously anticipated or newly discovered interference as provided in Section 4904 R. S. (Appendix, p. 17). That subsequent interferences do occur is evidenced by the facts of many cases, see *Gold v. Newton*, 254 F. 824; *Radlke Patent Corp. v. Coe*, 122 F. (2d) 937. Subsequent Patent Office prosecution might also comprise action for the first time upon the merits of an invention, as in a case in which the Board of Appeals refused a patent upon the sole grounds that the applicant could not claim the invention at all, as in *Steinmetz v. Allen*, 192 U. S. 543; *Frasch v. Moore*, 211 U. S. 1, and *Pitman v. Coe*, 68 F. (2d) 412.

The concept that the District Court has no jurisdiction where further proceedings may take place in the Patent Office upon the return of the application is believed to be obvious error. The statutory duty placed upon the Commissioner by the Revised Statutes, Section 4904 (Appendix, p. 17) and Rules 94 and 95 of the Rules of Practice in the United States Patent Office (Appendix, pp. 23, 24,) require the Commissioner to exercise the judicial function (*Ewing v. U. S. ex rel Fowler Car Co.*, 244 U. S. 1) of determining the existence or non-existence of an interference with respect to the application. In the case in which an

applicant obtained the allowance of the claims for the first time in a 4915-action the Commissioner would not have had the opportunity previously to exercise this function, the patentability of the claims to the various parties being a prerequisite for an interference (R. 94, Appendix, p. 23). If the Court of Appeals recognizes the duty resting upon the Commissioner then logically it can never take jurisdiction of an action brought under Section 4915 R. S.

Trade-mark cases brought under Section 4915 R. S. are subject to the "same rules of practice and procedure" (*American Steel Foundries v. Robertson*, 262 U. S. 209; *Atkins v. Moore*, 212 U. S. 285) as in patent cases. The Court of Appeals for the District of Columbia does not deny its jurisdiction in such cases where upon returning to the Patent Office further prosecution may take place in "complying with the requirements of law," as is evidenced by its decision in the case of *Thorne, Neale and Co. v. Cae*, 143 F. (2d) 155, 62 U. S. P. Q. 22, decided after the present case was argued.

If the Patent Office prosecution of an application must have been completed in order properly to bring an action under Section 4915 R. S. then a great number of actions have been brought under Section 4915 R. S. in error, both before and after the Act of 1927 (Appendix, p. 11) in which the appeal and the bill in equity are made alternate remedies. Where the grounds of rejection was one of estoppel, or where claims were copied from a patent for purposes of interference, or where an interference was dissolved and the claims were later rejected on any grounds, or where the record showed that another party was claiming the same invention, further Patent Office prosecution would clearly be necessary and have been heard by the District Courts in error. Examples are: *Barrett v. Ewing*, 242 F. 506, C. C. A.

2nd, 1917; *Gold v. Newton*, 254 F. 824, C. C. A. 2nd, 1918; *International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869, App. D. C. 1936; *Du Pont v. Coe*, 89 F. (2d) 679, App. D. C. 1937; *American Cyanamid v. Coe*, 106 F. (2d) 851, App. D. C. 1939; *American Viscose Corp. v. Coe*, 106 F. (2d) 849, App. D. C. 1939; *Power Patents Co. v. Coe*, 110 F. (2d) 550, App. D. C. 1940; *Bendix Aviation Corp. v. Coe*, 61 U. S. P. Q. 78, D. C. D. C. 1943; *Bates et al v. Coe*, 40 U. S. P. Q. 220, D. C. D. C.; *Tinnerman Products v. Coe*, 50 F. S. 337, D. C. D. C.; *Gyro Process Co. v. Coe*, 107 F. (2d) 195, 42 U. S. P. Q. 413. It is to be presumed that the Courts in these cases assumed the duty which was theirs of determining their own jurisdiction. *Minnesota v. Hitchcock*, 185 U. S. 373; *Reid v. U. S.* 211 U. S. 529.

A detailed discussion of many specific cases in which subsequent prosecution in the Patent Office would necessarily take place after the decision in a 4915 action is set forth hereinafter under part 1 C.

That a decision not going to the merits but instead requiring an applicant to divide his application and claim parts of his invention in separate applications is "final and appealable" was determined by this Court in *Steinmetz v. Allen*, 192 U. S. 543. The Court there said:

"True, a distinction can be made between his ruling and one on the merits, if we regard the merits to mean invention, novelty or the like. But in what situation would an applicant for a patent be? If he yield to the rule he gives up his right of joinder. If he does not yield he will not be heard at all, and may subsequently be regarded as having abandoned his application. See. 4894, Rev. Stats. A ruling having such effect must be considered as final and appealable."

In the *Steinmetz* case Steinmetz was seeking a writ of *mandamus* to compel the Commission to forward his appeal from the Examiner making the requirement of division to the Examiners-in-Chief (now Board of Appeals). This Court's decision was that the Examiner's holding was "final." Clearly an affirmance of the Examiner by the Board of Appeals upon appeal would render the decision no less "final."

1Bb. *The Refusal Of A Patent Upon Any Grounds Is Reviewable Under Section 4915 R. S.*

Revised Statute 4915 (Appendix, p. 20) provides a remedy by bill in equity when a "patent or application is refused" by the Board of Appeals. "No limitation is provided as to the grounds of the Board's refusal. Clearly in the performance of its judicial function (*Butterworth v. Hoe*, 112 U. S. 50; *U. S. ex. rel. Bernardin v. Duell*, 172 U. S. 576; *Ex parte Frasch*, 192 U. S. 566; *American Steel Foundries v. Robertson*, 262 U. S. 209; *Cleveland Trust Co. v. Berry*, 99 F. (2d) 517; *Steinmetz v. Allen*, 192 U. S. 543; *Johannessen v. U. S.*, 225 U. S. 227; *Frasch v. Moore*, 211 U. S. 1; the Board can base its decision upon any ground it sees fit, as can a Court in making a decision. The decision is final so far as the applicant is concerned for he is deprived of his patent. It is no less final, from his aspect, merely because subsequent prosecution may be necessary should the decision be reversed. The decision of the lower Court adding limitations as to the grounds upon which the "patent or application is refused" and still bring the refusal within the statute must be considered judicial legislation.

The refusal of a patent upon one ground has the same final effect as the refusal upon another ground and Section 4915 R. S. does not distinguish. Petitioner was re-

refused a patent containing certain claims upon the grounds that they did not read upon his invention (R. 129). Frash, in the case *Frash v. Moore*, 211 U. S. 1, was denied a patent because of his refusal to comply with a requirement of division, there having been no action upon the merits. Frash appealed to the Court of Appeals for the District of Columbia which then had the jurisdiction now residing in the Court of Customs and Patent Appeals under Section 4911 R. S. (U. S. C. Title 35, Sec. 35a) Appendix, p. 19). This Court in dismissing the appeal and writ of error and in denying *certiorari* said:

“... the decision of that Court (in the action under Section 4911 R. S.) may be challenged generally and a refusal of patent may be reviewed and contested by bill (under Section 4915 R. S.) as provided.” (Parenthetical matter added.)

1Be. *The Remedy Under Section 4915 R. S. Is Co-extensive With The Remedy Under Section 4911 R. S.*

In *Baldwin Co. v. Robertson*, 265 U. S. 168, 44 Sup. Ct. 508, a trade-mark case to which the provisions of Section 4915 R. S. apply in the same manner as to a patent case, the plaintiff had filed his bill under Section 4915 R. S. seeking an *injunction* to prevent the Commissioner from canceling certain trade-marks. Against jurisdiction it was argued that Section 4915 R. S. did not authorize the action. Mr. Chief Justice Taft said, in rejecting the defendant's contentions:

“The next inquiry is whether, in addition to such appeal and after it proves futile, the applicant is given a *remedy by bill in equity as provided for a defeated applicant for a patent in § 4915, Rev. Stats.* We have in the cases cited given the closing words of § 9 a liberal construction in the view that Congress intended by them to give every remedy in respect to trade marks

that is afforded in proceedings as to patents, and have held that under them a bill of equity is afforded to a defeated applicant for trade mark registration just as to a defeated applicant for a patent. It is not an undue expansion of that construction to hold that the final words were intended to furnish a remedy in equity against the Commissioner in every case in which by § 9 an appeal first lies to the Court of Appeals. This necessarily would give to one defeated by the Commissioner as a party to an application for the cancellation of the registration of a trade-mark, after an unsuccessful appeal to the advisory supervision of the Court of Appeals, a right to resort to an independent bill in equity against the Commissioner to prevent cancellation." (Italics supplied).

As the statute is not to be distinguished in its application to trade-mark and patent cases it is clear that the appeal and the subsequent 4915 action are too extensive.

The case of *Baldwin v. Robertson* should not be left without also emphasizing the scope of the remedy held available under Section 4915 R. S. The bill sought an injunction and not a determination that the plaintiff was entitled to receive a trade-mark registration. The statute provides that if the finding be in favor of the applicant the court "shall authorize the commissioner to issue such patent." There is no express provision here as to the issuance of an injunction and the holding of this Court clearly shows the liberality with which this statute has been interpreted in the past.

The case of *Clements v. Kirby*, C. C. A. 6th, 1921, 274 F. 575, 586, was an *inter partes* action under Section 4915 R. S. and in which the jurisdiction of the Court was in question. The Court said:

"It is well established that the court appealed to under Section 4915 has full jurisdiction to re-examine all matters determined by the Court of Appeals."

That appeal under R. S. 4911 and a bill in equity under R. S. 4915 are alternative remedies since the amendment of 1927 has been determined by the courts.

In *Wettlaufer v. Robins*, (C. C. A. 2) 92 F. (2d) 573, (1937) the court said:

"Thus, for many years, it had been the policy of Congress to permit an applicant who was refused a patent by the departmental tribunals of the Patent Office—and even after review by the Court of Appeals of the District of Columbia—to have his asserted property right to the invention determined de novo by a court of original jurisdiction."

"The purpose of the amendments was to reduce the number of appeals in the Patent Office (35 U. S. C. A. Sec. 7) to require a *defeated applicant to elect between appealing to the Court of Appeals of the District of Columbia and suing under Section 4915* as amended (35 U. S. C. A. Sec. 63), and, when applicant in an interference appealed from the Board of Appeals, to permit his adversary to have the appeal dismissed and further proceedings conducted by bill in equity (35 U. S. C. A. Sec. 59a). Thus *no refused applicant was to be deprived of his right to sue in equity after an adverse decision by the Board of Appeals, except by his own election to appeal to the Court of Appeals of the District of Columbia, or, if such appeal was dismissed at the instance of his adversary, by his own failure to file his bill within thirty days thereafter.*" (Italics supplied.)

In *Chase v. Cor*, 31 F. S. 935 affirmed by the Court of App. D. C., 122 F. (2d) 198, the court said:

"\* \* \* it (the passage of the Act of 1927) is evidence of the intention of Congress to require an election by the party as between the two remedies offered to him: \* \* \* (Parenthetical matter added.)"

Revised Statute, Section 4915 was subsequently amended on March 2, 1929. The Circuit Court of App. 2nd, in *Bake-life Corp. v. Nat'l Aniline & Chemical Co.*, 83 F. (2) 176 said:

"In the subsequent reenactment of the statute; substantially in the same form, this prior judicial construction although rendered by an inferior court is at least persuasive indication of the interpretation adopted by Congress."

In *Pitman v. Coc*, 68 F. (2d) 412, (1933) the Court of App. D. C., said:

" \* \* \* These two remedies lie to different courts. They differ in procedure, the one is an appeal upon the record of the Patent Office, and the other is an original suit in a court of equity. The latter proceeding calls for a trial de novo with all the customary power of an equity court to hear the evidence fully and to make its own findings. Although these two methods of procedure are alternatives, they are nevertheless analogous and are designed to secure essentially the same legal remedy."

" \* \* \* We can see no reason for holding that such a remedy is confined to a review by the appellate court of the decisions of the Patent Office, and is denied in proceedings brought by the applicant for review in a court of equity. It is true that the remedies are diverse; nevertheless the substantive rights of the applicants, which are the basis alike of the appeal and bill in equity, are identical. *There is no reason to believe that Congress intended that any remedy which might be obtained by appeal should be more extensive or complete than that allowed by bill of equity.* It follows that a refusal to grant a patent based upon a controversy arising from an order of division is reviewable by either proceeding. The difference between the two is a difference of procedure rather than a difference of interest. In this view of the case we think that the lower court possessed jurisdiction to

hear and decide the question notwithstanding that the refusal of the patent was based upon an order of division of claims made in the Patent Office." (Italics supplied.)

In *Bakelite Corporation v. National Aniline and Chemical Co.*, (C. C. A. 2) 83 F. (2d) 176, 1936, the court said:

"It cannot be doubted that the statute, as it now reads, means to give alternative remedies to an applicant, to whom a patent has been refused. He may appeal, in which case he waives his right to proceed under section 63 of this title' (35 U. S. C. A. 59a); or he may have his remedy by bill in equity, unless appeal has been taken from the decision of the board of appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section."

The remedies provided by Section 4911 R. S. and Section 4915 R. S. have, since 1927, been considered as "alternative and mutually exclusive" (*Hemphill Co. v. Coe*, App. D. C. 121 F. (2d) 897 (1941) remedies available to the applicant refused a patent in the Patent Office (*Jensen v. Lorenz*, 92 F. (2d) 992, *certiorari* denied, 302 U. S. 751). This fact is also clearly evidenced by the wording of Section 4911 R. S. which in part reads as follows:

"If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under Section 4915 of the Revised Statutes."

The Patent Office clearly recognizes the equivalence of the remedies as evidenced by Rule 149 (Appendix, p. 31) of the Rules of Practice in the United States Patent Office which provides:

"If an applicant in an ex parte case appeals to the U. S. Court of Customs and Patent Appeals he waives his right to proceed under Section 4915 R. S. (U. S. C. Title 35, Sec. 63)."

"From adverse decisions by the Board of Appeals in ex parte cases and from decisions of the Board of Interference Examiners, the appellant, if an applicant, has the option of proceeding under Section 4915 R. S. instead of appealing directly to the U. S. Court of Customs and Patent Appeals."

The law as laid down in the statutes, in the decisions of the courts, and as deducible from the practice before the courts is in agreement with petitioner's contention that the District Court had jurisdiction. Those decisions and that practice are consistent with the interpretation of Section 4915 R. S. in the light of its history as discussed in part 1A of this brief. As was stated in the "Memorandum for the Commissioner of Patents" (p. 9) prepared by the Solicitor General in reply to petitioners "Petition for a Writ of Certiorari":

"It (the decision below) is admittedly inconsistent with past practice under Rev. Stat. 4915." (Parenthetical matter inserted.)

1Bd. *The Decisions Cited By The Court Below Do Not Support the Holding.*

The Court below said (R. 142):

"Turning now to the cases we find an explicit ruling by the Supreme Court that a proceeding under Section 4915 R. S. cannot select a single issue which affects plaintiff's right to a patent, without determining all the other issues on which that right depends.";

citing *Hill v. Wooster*, 132 U. S. 693.

Actually all that was held in *Hill v. Wooster* was that in an inter parte action under 4915 the question of patent

ability is always present. In *Hill v. Wooster* it appeared that the subject matter of the interference was unpatentable and the Court so held. In *inter partes* 4915 actions the Commissioner is not a necessary party and usually is not a party, and, accordingly, the Court properly protects the public interest by inquiring into the patentability of the subject matter. Should new evidence appear in the case, or should the Court be of the opinion that the issues are unpatentable, clearly it should have the power to so rule and this the Court did in *Hill v. Wooster*.

In an *ex parte* case, however, the Commissioner of Patents is the sole party defendant and there is no reason for the Court to assume that the public interest is not being protected. All reasons which the Commissioner wishes to raise to oppose the applicant's right to a patent, he can raise in his answer and does so except where under the accepted procedure an issue of priority is to be determined by subsequent prosecution in the Patent Office.

Under the law (Section 4904 R. S.) (Appendix, p. 17) the issues must be determined to be patentable to each of the interfering parties before the interference can be contested. The statute in itself is substantially a complete answer to the contention that *Hill v. Wooster* should be interpreted sufficiently broadly as to imply that the issue of priority should be contested before the question of patentability has been determined. To permit the questions of patentability and priority to be raised simultaneously, the question of priority being determined for the first time by the Court in a 4915 action, would be to substitute the Court for the Patent Office which, obviously, is not the intent of the law, the Patent Office being the agency specifically named by Congress to perform those duties.

In *Butterworth v. Hoe*, 112 U. S. 50 (1884), cited by the lower Court in a footnote, this Court merely defined the

nature of the action contemplated by Section 4915, and, in emphasizing the de novo character thereof, distinguished it from an appeal under Section 4911. This case did not touch upon the jurisdictional questions raised in the present case.

The Court below cited *Synthetic Plastics Company v. Ellis-Foster Company*, 78 F. (2d) 847, C. C. A. 3rd, 1935, and *Cherry-Burrell Corporation v. Coe*, 62 U. S. P. Q. 20, as authority for the proposition that the Court had no jurisdiction over intermediate proceedings in the Patent Office.

The *Synthetic Plastics Company Case* was an R. S. 4915 action seeking the review of the granting of a motion to dissolve an interference which the Court said was an interlocutory and not a final order. The order dissolving an interference is not final and appealable even under Section 4911 R. S. and, accordingly, it is not surprising that the Court was held to have no jurisdiction under 4915 R. S.

In the *Cherry-Burrell* case, the Court held that it had no jurisdiction to pass on the patentability of claims which were refused entry by the Patent Office after a decision by the Board of Appeals on other claims. Actually all the Court held was that it had no jurisdiction to pass on the patentability of claims which had not been considered by the Patent Office and therefore not twice rejected, that is, finally refused.

In *Hazeltine Corporation v. White*, 68 F. (2d) 715, C. C. A. 2d, 1934, cited by the Court below as authority for the proposition that the patentee Bergholm was an indispensable party below, does not support that contention. In the *Hazeltine* case, three parties were involved in an interference in the Patent Office and an award of priority was made

to one of them. One of the losers brought an action under R. S. 4915 in the District Court of the Second Circuit while, at the same time, a three-party R. S. 4915 action was pending in the District Court for the District of Columbia. The Court merely held that the third party to the interference was an indispensable party and that it would be futile to decide the case as between the two parties when another case was already pending in which all parties to the controversy were before the Court. It should be noted that in the *Hazeltine* case there had actually been an interference in the Patent Office so that the opposing parties were properly adverse parties under the law as discussed in part 3 of this brief. In the instant case, however, no interference having been set up in the Patent Office, there are no adverse parties other than the Commissioner.

The Court below also cited in a footnote the case of *Smith v. Carter Carburetor Corporation*, 130 F. (2d) 555, C. C. A. 3d, 1942, as supporting the proposition that the rival claimant is an adverse party and that issue of readability may be a most crucial one. That the issue may be crucial is clearly evidenced by the fact that it was grounds upon which the petitioner's claims were rejected by the Patent Office. The fact that the rival claimants were adverse parties in the *Smith v. Carter Carburetor Corporation* case is entirely proper under the law, (see part 3 of this brief) there having been an interference involving these parties in the Patent Office. In the present case there was no interference, the Commissioner having refused to set one up.

1C. THE DECISION OF THE COURT OF APPEALS IS INCONSISTENT WITH THE ACTUAL WORKING OF THE PATENT SYSTEM AND WITH THE RULES OF PRACTICE IN THE UNITED STATES PATENT OFFICE.

The view held by the Court of Appeals as to the reasons for the refusal of a patent is entirely inconsistent with the facts and procedures as they exist in the Patent Office.

Many applications having a simple, straightforward history of prosecution in the Patent Office might, under the lower court's holding, be entitled to the relief of Section 4915 R. S. A great many other applications, however, and often through no intent of the applicant, have more involved prosecutions in the Patent Office and to refuse the statutory relief to these cases is clearly without sound reason. The applicant, if denied his patent, is entitled to the remedy provided regardless of the complexity of the previous prosecution. Eight examples of cases in which the statutory remedy would be denied by the decision below and for no sound reason, are as follows:

a. In a case in which the refusal of the patent is upon the grounds of estoppel for failure to bring a motion as provided by Rule 109 (Appendix, p. 8), Rules of Practice of the Patent Office.

Where the applicant's patent is refused *ex parte* upon the grounds of estoppel and where the award of priority in an interference is upon the grounds of estoppel, the record in a subsequent action brought under Section 4915 R. S. will show this fact and will also show that a subsequent interference may be necessary upon a favorable decision for the complainant. Under the doctrine of the instant case applicants in such cases would be deprived of their right to file the bill in equity under Section 4915 R. S. The Court refers to two such cases (*International Cellulose Products Co. v. Coc*, 85 F. (2d) 869; *American Cyanamid Co. v. Coc*, 106 F. (2d) 851) in the decision below. Prior to the present decision the Courts have passed upon many such cases under Section 4915 R. S.

b. In cases where the claims are copied from a patent and are later rejected.

In the instant case one of the four claims was copied from the Bergholm patent (R. 134) for purposes of interference and, with the other three claims, was refused by the Patent Office. The same situation was present in the concurrently decided case, *Colgate-Palmolive-Peet Co. v. Coc*, 144 F. (2d) 517, 62 U. S. P. Q. 121, in which the instant case was cited as the law supporting the above proposition. As a matter of fact the subsequent interference may never materialize for the patentee cannot be forced into an interference. He may disclaim, or he may file a reissue application, and omit the copied claim.

c. In any case in which an interference is dissolved upon any grounds.

The doctrine of *Hoover v. Coc* as decided below will deny all applicants the right to have the refusal of their patent reviewed by bill in equity under Section 4915 R. S. where the applicant was previously involved in an interference and the interference was dissolved under the governing Patent Office rules upon any grounds whatsoever. The lower Court has so applied the law of *Hoover v. Coc* in *Line Material et al. v. Coc*, 144 F. (2d) 518, 62 U. S. P. Q. 120.

d. In any case in which a party is eliminated from a multi-party interference upon the ground that he is not entitled to make the claim.

In such a case the interference would continue to an award of priority with the eliminated party prosecuting his application *ex parte*. *Gyro Process Co. v.*

*Coe*, 70 App. D. C. 390, 107 F. (2d) 195. Under the doctrine of *Hoover v. Coe* the parties to the interference and the *ex parte* applicant would have no right to a bill in equity under Section 4915 R. S. for, should the eliminated applicant subsequently prove his right to make the interference counts, a second interference would have to be instituted.

e. In the case in which some of an applicant's claims have been allowed.

The Court below, in holding that applicant had no right to a bill in equity under Section 4915 R. S. when only certain of his claims had been refused, in effect held that unless all of the claims were refused there had been "no refusal of a patent" as provided in Section 4915 R. S. This is contrary to a long established practice, *Gyro Process Co. v. Coe*, 107 F. (2d) 195; *Tully v. Robertson*, 19 F. (2d) 954; *Steinmetz v. Allen*, 192 U. S. 543; *Frasch v. Moore*, 211 U. S. 1. Under the doctrine of this case an applicant who has, for example, one narrow claim allowed would be denied the right to file his bill in equity. A patent with a narrow claim is not the same as a patent with a broad claim. An applicant denied protection to which he is entitled is denied the patent to which he is entitled.

f. In a case in which the Board of Interference Examiners made a recommendation under Rule 126 (Appendix, p. 29) of the Rules of Practice in the United States Patent Office.

The Board of Interference Examiners may make a recommendation under Rule 126 (Appendix, p. 29) of the Rules of Practice in the Patent Office to the effect that after a judgment of priority in an interference, consideration should be given to any matter affecting the right of any party to a patent. Application of this

recommendation obviously would require further proceedings in the Patent Office after the determination of the issue of priority in an *inter partes* 4915 action, and would under the decision below, preclude the right to 4915 relief.

g. In a case in which the refusal of a patent is upon the grounds that the applicant had previously elected a different invention, or where the patent is refused upon the failure of the applicant to comply with a requirement for division.

In this case the patent would be refused upon the technical grounds and action upon the merits would necessarily follow a reversal of the Patent Office in an action brought under Section 4915 R. S. This holding, if unreversed, would comprise a complete bar to applicant's right to a patent yet under the decision in the instant case the applicant would be given no right to contest the matter under Section 4915 R. S. The lower Court's decision on this point is inconsistent with the decisions of this Court in *Steinmetz v. Allen*, 192 U. S. 543, *Ex parte Frasch*, 192 U. S. 566, *Frasch v. Moore*, 211 U. S. 1.

h. In any case in which an application has been involved in an interference in the Patent Office.

If jurisdiction does not reside with the District Court when further Patent Office prosecution may be necessary then the Courts will never have jurisdiction in a case involving an application which has been involved in an interference in the Patent Office. In such cases Rule 96 (Appendix, p. 25) specifically provides for further proceedings in the Patent Office including the possibility of a further interference.

The Commissioner of Patents is the administrative body specifically designated by Congress to administer the Patent Laws insofar as the issuance of patents are concerned; Section 484 R. S. (U. S. C., Title 35, Section 6) (Appendix, p. 16).

There can be no doubt that the administrative rules set up by the administrative body having jurisdiction of the administration of an act of Congress over a long period of time, during which the act was frequently amended with such rules in view, should be virtually conclusive as to the interpretation of the statutes in question. *Dismuke v. U. S.*, 297 U. S. 167; *Scott Logan v. Davis*, 233 U. S. 613; *Kern River Co. v. U. S.*, 257 U. S. 147; *U. S. v. State of Minnesota*, 270 U. S. 181; *U. S. v. Jackson et al.*, 280 U. S. 183; *United States v. Moore*, 95 U. S. 760; *Hastings et al. v. Whitney*, 132 U. S. 357; *United States v. Alabama G. S. R. Co.*, 142 U. S. 615; *Kindred v. Union P. R. Co.*, 225 U. S. 582.

Under the decision below practically all of the rules of the Patent Office relating to the administration of R. S. Sec. 4904 (Appendix, p. 17) will have to be changed if an applicant's rights provided by statute are to be preserved. These rules "have the force and effect of law" (*Ewing v. United States, ex rel. Fowler Car Co.*, 244 U. S. 1), and comprise "an authority under the United States" (*Steinmetz v. Allen*, 192 U. S. 543, 556).

Rules 93, 94, 95 and 96 of the Rules of Practice in the Patent Office (Appendix pp. 22, 23, 24, 25) require that the counts or claims be patentable to all parties before an interference is declared. The Court below in refusing the remedy of Section 4915 R. S. to petitioner said:

"Before plaintiff here is entitled to a patent it must establish priority over the patent from which the claims are copied." (R. 142).

But the Patent Office had refused petitioner's request (R. 6, 115) to set up an interference to determine the question of priority holding that the claimed subject matter was not patentable to petitioner and so, under Rules 93, 94, 95 and 96, that an interference was not proper. (*Ewing v. U. S. ex rel Fowler Car Co.*, 244 U. S. 1, 7).

If in the opinion of the Commissioner, the claims were not patentable to applicant, clearly the Patent Office did not err in refusing to set up the interference for, under Section 4904 R. S. (Appendix p. 17), it is the "opinion of the Commissioner" which determines whether an interference is to be declared. Petitioner's right to those claims was a prerequisite to an interference in the Patent Office yet the Court below demands the impossible, and requires the interference before it will determine petitioner's right to a patent containing those claims.

Rule 63(d) of the Rules of Practice in the United States Patent Office (Appendix p. 22) provides for rejecting claims copied from a patent, as in petitioner's case, and for ex parte appeal from such rejection within a set time limit. The rule also provides that failure to appeal within the set time will be "deemed a disclaimer of the invention claimed." This was petitioner's exact position. His failure to proceed ex parte to a higher tribunal would have effected a permanent bar to his right to a patent containing the subject matter of interest. Conceivably this subject matter is the only matter of real importance in his application. The lower Court views the refusal to applicant of a patent containing such subject matter, even though it is final and appealable, as merely procedural and so not such as to entitle an applicant to his remedy under Section 4915 R. S. Such a view is irreconcilable with the doctrine of *Steinmetz v. Allen*, 192 U. S. 543, discussed *supra*.

Rule 96 of the Rules of Practice (Appendix, p. 24) in the United States Patent Office provides for the setting up of other interferences after a judgment of priority in a first interference. Had petitioner managed to have the interference set up, and had he taken the opposing party before the lower Court, all of which that Court held necessary to its own jurisdiction (R. 142), the fundamental objection raised

by the Court would not have been cured. Upon the return to the Patent Office after a favorable decision petitioner, under the provisions of Rule 96, might have been confronted by still another interference. This second interference he might lose and the patent "authorized" by the Court would never issue. To the lower Court such a result was objectionable in that the mandate of the Court would be ignored (R. 145). When it is remembered, however, that the Statute Section 4915 R. S. specifically provides that an applicant is entitled to a patent after a favorable decision in a 4915 action only upon "otherwise complying with the requirements of the law" the objection raised by the lower Court is more difficult to understand.

Rules 111, 116, 122, 123 and 124 in the United States Patent Office (Appendix pp. 27, 28, 29) relate to motions to dissolve and with the dissolution of interferences. No award of priority is made upon the dissolution of an interference. In many instances a party's right to engage in an interference is denied after the interference has been declared rather than before as in petitioner's own case. An applicant whose application had been in a dissolved interference would, under the doctrine of the decision below, be forever barred from his remedy under Section 4915 R. S. for a favorable decision might necessitate the reinstatement of the dissolved interference.

Rule 126 (Appendix, p. 29) has to do with calling the Commissioner's attention to facts, which came to the notice of the board of interference examiners and which would indicate that the claims are unpatentable to either party and provides for further proceedings in the Patent Office in such a case.

Rule 130 (Appendix, p. 29) of the Patent Office has to do with the question of raising patentability of the issue to

an opponent as a basis for a priority decision only when a motion had been duly brought.

Rule 133 (Appendix, p. 30) provides for appeals to the Board of Appeals and includes the question of division or previous election which do not go to the merits in the sense of novelty, patentability, etc., and the decision of which would not end the prosecution of the case before the Patent Office.

Rule 141 (Appendix, p. 30) specifically provides for further proceedings in the Patent Office after a decision by an appellate tribunal.

And Rule 149 of the Rules in the United States Patent Office (Appendix p. 31), as discussed above, is a clear-cut statement of the understanding of the Commissioner of Patents and of the Patent Office as to the statutory law and with that understanding the decision below is irreconcilable. The rule reads in part:

"From adverse decisions by the board of appeals in ex parte cases and from decisions of the board of interference examiners, the appellant, if an applicant, has the option of proceeding under Section 4915 R. S. instead of appealing directly to the U. S. Court of Customs and Patent Appeals."

All of the foregoing rules are inconsistent with the decision below and are consistent with the concept of further proceedings in the Patent Office after a favorable decision in a suit brought under Section 4915 R. S. Under the decision below, if the District Court is to have jurisdiction further proceedings must not take place in the Patent Office. If an applicant's rights under Section 4915 R. S. are to be preserved, under the decision below those rules must be changed.

The Commissioner of Patents has the duty of issuing valid patents to the true inventors, (Sec. 4886 R. S., Appendix p. 17). No decision by a court can force him to issue an invalid patent unless the issues raised by his refusal to grant the patent are res adjudicata. The statute leaves it to the opinion of the Commissioner as to when interferences should be declared. (Sec. 4904 R. S., Appendix p. 17) Rule 94 of the Rules of Practice (Appendix p. 23) clearly establishes that in the "opinion" of the Commissioner no interference should be set up until the claims to the same invention "are allowable in all the applications involved." It follows then, that whenever claims are rejected and a patent refused there may be a potential interference which has never been indicated. Clearly an applicant's right to the relief of Section 4915 R. S. particularly in view of the history thereof and in view of the decisions of the courts, should not be made to depend upon incidental mention of the existence of a future interference when it is an indisputable fact that such an interference is a possibility in every case.

An interference is a costly time-consuming procedure. To require every patentee to defend his right to claims against all comers, whether having any color of right there to or not, is clearly not desirable from the standpoint of the patentee or the Patent Office. Orderly procedure clearly cries out against the decision below.

**1D. UNDER THE DECISION BELOW IT IS IMPOSSIBLE, FIRST, FOR A COURT EVER TO DETERMINE ITS JURISDICTION CONCLUSIVELY, AND SECOND, FOR AN APPLICANT TO DETERMINE WHETHER BY BRINGING AN ACTION UNDER SECTION 4915 R. S. HE MAY NOT EFFECT THE ABANDONMENT OF HIS APPLICATION.**

The decision of the Court below, as applied in subsequent decisions of that Court, bases jurisdiction of the

District Court in a 4915 action upon an indeterminant factor comprising the degree of likelihood of further proceedings in the Patent Office.

In *Colgate-Palmolive-Peet Company v. Coe*, 144 F. (2d) 517, 62 U. S. P. Q. 121, the doctrine of the present case was applied, while in *Minnesota Mining Company v. Coe*, 62 U. S. P. Q. 119, the doctrine was not applied. These cases were decided on the same day. The facts were substantially the same. In each case the record disclosed that a subsequent interference might take place if the decree was in favor of the complainant, and that the complainant would be the senior party in such interference.

In the present case and in the *Colgate* case the doctrine was applied and jurisdiction denied, the Court below in effect holding that the possibility of future proceedings was too proximate. In the *Minnesota Mining* case the doctrine was considered and not applied, the Court below holding in effect that the possibility of future proceedings was too remote.

If the decision below is not reversed, the District Courts will have difficulty in deciding when it does and when it does not have jurisdiction. By the same token applicants will never know whether or not to file a bill under Section 4915 R. S. and take the chance of losing the right of review both under Section 4911 R. S. and Section 4915 R. S.

The only circumstance in which a court could be sure that its determination of its jurisdiction in a 4915 action is well based, under the decision below, is the case in which it positively appears in the record that subsequent prosecution will take place in the Patent Office. Then the court would know, under the decision below, that it had no jurisdiction. In every other circumstance the court in determining its jurisdiction would be confounded by the knowledge

that upon the return of the application to the Patent Office further prosecution might ensue. As examples of subsequent prosecution which may arise in any case:

1. The application returns to the Patent Office and the Commissioner is "of the opinion" that it should be placed in an interference. He sets this interference up under Section 4904 R. S. The opposing application might have been filed after the filing of the 4915 action. The future interference could not have been foreseen in such a case.

2. The application returns to the Patent Office and the Commissioner discovers anticipatory art, previously unknown, which completely negatives the applicant's right to a patent under the statutes even though he was successful in the 4915 action. Under the law (Section 4886 R. S.) (Appendix p. 16) the Commissioner cannot issue a patent to one not entitled to it and accordingly he must ignore the mandate of the court.

Just as the court could never be sure of its jurisdiction so the applicant refused a patent could never be certain that if he filed his bill in equity under Section 4915 R. S. he would not be abandoning his application and possibly all rights to a patent.

Under the decision the decisions of the Patent Office can become final and adverse to the applicant in all cases where a bill under Section 4915 R. S. is filed. The Commissioner need only state in his answer that, should the decree be favorable to the applicant, further proceedings in the Patent Office will be necessary. The District Courts would then, under the law of this case, lack jurisdiction. The 40-day period for appeal under Section 4911 R. S. to the Court of Customs and Patent Appeals would have long since passed. See Rule 149 (Appendix p. 31) Rules of Practice

of the Patent Office and Rule XXV of the Court of Customs and Patent Appeals (Appendix, p. 32). The applicant (as has petitioner in this case) would then be deprived of his right to review under Section 4911 R. S. and the decision of the Patent Office would be final insofar as applicant was concerned.

It would appear reasonable to assume that the remedy provided by Section 4915 R. S. will become a hollow shell without substance if the decision below remains the law. For the reasons above suggested applicants would fear to file their bill in equity. Clearly a surprising ending for an action which has had the color and the history of Revised Statute 4915.

**2. The Provision In Section 4915 R. S. Of A "Remedy By Bill In Equity" . . . "Whenever A Patent On Application Is Refused By The Board Of Appeals Or Whenever Any Applicant Is Dissatisfied With The Decision Of The Board Of Interference Examiners," Provides For Remedies Under Two Separate Conditions.**

Section 4915 R. S. (Appendix, p. 32) clearly provides a patent applicant in the United States Patent Office with remedies in two distinct cases. He may file a bill in equity:

- (1) "Whenever a patent on application is refused by the Board of Appeals"

"or"

- (2) "Whenever . . . dissatisfied with the decision of the board of interference examiners."

The decision of the Court below refuses to grant an applicant the remedy of (1) unless (2) is also present in any case where an interference might be set up at a later date. The word "or" is interpreted to mean "and."

The decision below requires that the interference be set up even though the Commissioner is of the opinion that none should exist. Such a holding is clearly inconsistent with the holding of this Court in *Ewing v. Fowler Car Co.* (244 U. S. 1). The Court there said:

"If it could be conceded that there is antagonism between Sec. 4904, and the rules, the former must prevail. *Steinmetz v. Allen*, 192 U. S. 543, 565. But there is no antagonism. The former provides that 'when-ever an application is made for a patent which, *in the opinion of the Commissioner*, would interfere with any pending application. \* \* \* he shall direct the primary examiner to proceed to determine the question of priority of invention.' The section, therefore, commits to the opinion (judgment) of the Commissioner the effect of an application upon a pending one—whether it will interfere with a pending one; something more, therefore, than the fact of two applications, something more than the mere assertion of a claim. The assertion must be, in the opinion of the Commissioner, an interference with another. And it is this other that is first in regard, not to be questioned except at the instance of the Commissioner by an exercise of judgment upon the circumstances. And there is no defeat of ultimate rights; there may be postponement of their assertion remitted to a suit in equity under Sec. 4918."

The same case is authority for the statement that in the present case the applicant could not mandamus the Commissioner to institute the interference which the lower Court contends must exist if it is to have jurisdiction.

The holding below clearly ignores the express provisions of Section 4904 R. S. (Appendix, p. 17), which reads in part as follows:

"Whenever an application is made for a patent which, *in the opinion of the Commissioner*, would interfere with any pending application, or with an un-

expired patent, he \* \* \* shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention." (Italics added.)

It also ignores Rule 94 (Appendix, p. 23) of the Rules of Practice in the United States Patent Office which rules comprise an authority "under the United States" (*Steinmetz v. Allen*, 192 U. S. 543, 556). Rule 94 provides:

"Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same invention *which are allowable in the application of each party*, and \* \* \* between applications for patent, or for reissue, and unexpired original or re-issued patents, of different parties, when such applications and patents contain claims for substantially the same invention *which are allowable in all of the applications involved*; \* \* \* " (Italics added.)

To arrive at its holding the Court of Appeals must interpret "or" to be "and" and in doing so violates established principles of statutory interpretation.

In interpreting any statute in the absence of ambiguity, the ordinary meaning of its words and language control. *Maillard v. Lawrence*, 16 How. 251; *United States v. Wiltberger*, 5 Wheat. 76; *Ruggles v. Illinois*, 408 U. S. 526; *Putman v. Longley*, 28 Mass. 487.

It is well settled that conjunctive words are to be construed as disjunctive, and vice versa, when and only when it is necessary to effectuate the obvious intention of the legislature. *Beasley v. Parnell*, 177 Ark. 912, 9 S. W. (2d) 10; *In re Steinruck's Insolvency*, 74 A. 360, 225 Pa. 461; *Weir v. Bauer*, 286 Pa. 936; *State v. Tiffany*, 44 Wash. 602, 87 P. 932; 59 C. J. 986, Sec. 584; *Gar Creek Drainage Dist. v. Wagner*, 256 Ill. 338, 100 N. E. 190, 193; *Aurora*

*Brewing Co. v. Ind. Bd. of Ill.*, 277 Ill. 142, 115 N. E. 207; *Voight v. Indus. Comm.*, 297 Ill. 109, 130 N. E. 470; *State ex rel. Normile v. Cooney*, 100 Mont. 391, 47 P. (2d) 637.

If any question remains as to the fact that the word "or" is used in its disjunctive sense in Section 4915 R. S. it is believed that the history of the remedy, see part 1A *supra*, will readily dispel the doubt. By the Act of 1836 (Chart 1) the remedy was available only in inter parte cases. By the law of 1839 it was made available when the patent was "refused for any reason whatever". That provision was subsequently contracted in the Revised Statutes of 1894 to a shorter "refused", the meaning remaining as before.

It is believed that the holding in the decision below that the court could have no jurisdiction because petitioner had not contested priority of invention with Bergholm was clearly error. Petitioner had been finally refused the claims and therefore a patent containing those claims, the patent he sought, had been refused. No more was needed to give jurisdiction under Section 4915 R. S.

**3. In An Ex Parte Action Brought Under Section 4915 R. S. By An Applicant After Refusal Of A Patent By The Board Of Appeals, A Third Party Claiming The Same Invention Is Not A Necessary Party Where No Interference Between Applicant And The Third Party Was Instituted By The Patent Office.**

The Court below held it "had no jurisdiction over this suit" and gave as a reason that "The party against whom the plaintiff claims priority is not before the court" (R. 142).

The bill of complaint in the District Court (R.3) did not name any other party defendant than the Commissioner of Patents, nor did it claim priority with respect to any

other party save to allege (R. 6, paragraph 15) that the claimed invention of complainant's application was "new and useful and was not known or used by others in this country before Coons' invention thereof," as is required to entitle an applicant to a patent under Section 4886 R. S. (Appendix, p. 16). The Commissioner of Patents' answer (R. 8) did not deny the allegation of the complaint which, under F. R. C. P. 8(d) (Appendix, p. 32), was to be taken as admitted. As the Commissioner is the officer charged by law with the duty (Section 481 R. S.) (Appendix, p. 16) of issuing patents, this admission on the face of the pleadings was entitled to full acceptance.

There had been no interference in the Patent Office and there were no other adverse parties which could properly have been named parties defendant. *Druck H Co. v. Chamberlain Co.*, 10 F. S. 851, affirmed 81 F. (2d) 866; *Coe v. Hobart*, 102 F. (2d) 270; *Fessenden v. W. E.*, 10 F. S. 846. In the latter case the Court said:

"Plaintiff can bring no suit against the defendant in this or any other court because of an attempt to have an interference proceeding followed by the dissolution thereof. His only cause of action is against the Commissioner of Patents on the assumption that the dissolution of the interference proceedings, because of assumed lack of disclosure of the invention claimed, is equivalent to a denial of the patent. \* \* \*

*Coe v. Hobart*, 102 F. (2d) 270, was a 4915 action in which the Court of Appeals, D. C., said:

"Those cases hold that when an interference proceeding is terminated without a decision concerning priority, the situation is the same as if there had been no interference proceeding; the rival claimant is not an adverse party within the meaning of Section 4915, since there was no ruling that the trade-marks be-

longed to it, and one claimant may not sue the other under Section 4915, but must sue the Commissioner of Patents."

In *United States ex. rel. The Fowler Car Company v. Ewing*, 244 U. S. 1, this court said:

"Before the declaration of an interference all preliminary questions must be settled by the Primary Examiner, \* \* \*"

The District Court's jurisdiction as to such parties would be under the provisions of the second paragraph of Section 4915 R. S. (Appendix, p. 20) and the decisions deny such jurisdiction of another applicant or patentee in a 4915 action where no interference had been instituted in the Patent Office.

The decision below upon this point is directly contrary to the same court's decision in the trade-mark case decided after the instant case was argued. *Thorne, Neale and Co. v. Eoc*, 143 F. (2d) 155, 62 U. S. P. Q. 22. That trade-mark cases are parallel to patent cases has been mentioned before and has been definitely established. *Atkins v. Moore*, 212 U. S. 285; *American Steel Foundries v. Robertson*, 262 U. S. 209; *U. S. ex rel Baldwin v. Robertson*, 265 U. S. 168.

The holding below that the Court cannot give judgment authorizing the Commissioner to issue a patent to applicant containing the claims in issue in the absence of other parties claiming the same invention is inconsistent with Section 4918 R. S. (Appendix, p. 21). That statute clearly provides for the determination of the adverse interests of interfering patents.

The requirement that a potential future adverse party be made a party defendant in an *ex parte* 4915 suit, represents a departure from the practice followed in a long line of cases. In all cases in which the applicant is denied a pat-

ent upon the grounds of estoppel to make claims and where a subsequent interference would result should he succeed in a 1915 action the present holding in the lower Court requiring the naming of the potential interferant as a defendant is applicable. Cases evidencing that over a period of many years the Court below has not required the presence of the potential future interferant in such cases are here listed: *International Cellucotton Products Co. v. Coc*, 85 F. (2d) 869, App. D. C. 1936; *Du Pont v. Coc*, 89 F. (2d) 679, App. D. C. 1937; *American Cyanamid v. Coc*, 106 F. (2d) 851, App. D. C. 1939; *American Viscose Corp. v. Coc*, 106 F. (2d) 849, App. D. C. 1939; *Power Patents Co. v. Coc*, 110 F. (2d) 550, App. D. C. 1940; *Bendix Aviation Corp. v. Coc*, 61 U. S. P. Q. 78, D. C. D. C. 1943; *Bates et al. v. Coc*, 40 U. S. P. Q. 220, D. C. D. C.; *Tinnerman Products v. Coc*, 50 F. S. 337, D. C. D. C.; *Gyro Process Co. v. Coc*, 107 F. (2d) 195, 42 U. S. P. Q. 413. The Court of Appeals in the Second Circuit also has taken jurisdiction of such cases. *Gold v. Newton*, 254 F. 824; *Barrett v. Facing*, 242 F. 506. It is to be presumed that the Court in all of these cases assumed its duty of determining its jurisdiction. *Minnesota v. Hitchcock*, 185 U. S. 373; *Reid v. U. S.*, 211 U. S. 529.

Orderly procedure is inconsistent with the requirement that a patentee or an applicant having claims to an invention should be placed under the burden of defending every action involving such claims against adverse parties having no possible right thereto. The present procedure requiring an applicant to establish his right to claims before inviting the interference is consistent with such procedure.

### CONCLUSIONS.

It is believed to be clear that the decision below represents a denial of a right which has been unquestioned for over one hundred years, the right of an applicant for a

patent to bring suit in a court of equity when refused a patent containing the protection to which he believed himself entitled. That right is provided today by Section 4915 R. S.

There appears to be no compelling reason at this time to overturn a statutory interpretation which has controlled for so long a period of time. Were the established interpretation and practice truly violative of the language and the spirit of the Statute the decision below could be more readily accepted. Instead it is the new interpretation which ignores the history of the Statute, the ordinary and long-accepted meaning of the language used; the effect of related statutes; the established rules and practice in the United States Patent Office, the fact that subsequent prosecution in the Patent Office is a possibility in every case, and finally the impossibility of any court or any applicant ever determining accurately the question of jurisdiction in a 4915 action under the doctrine of the decision.

The Memorandum for the Commissioner of Patents, prepared by the Solicitor General and other able attorneys, aptly stated the weak basis for the decision below, saying:

"The Court found reasons of policy to support its conclusion." (p. 5).

What policy was it which compelled the conclusion in view of the obviously objectionable features thereof? As understood that policy is deducible from the following statement by the Court (R. 142):

"The idea that a court of equity should interfere with the proceedings of an administrative tribunal by a trial de novo at a stage when no decision on the merits can be given is contrary to the fundamental concept of equity jurisdiction."

This "policy" and the decision are inconsistent with the holding of this Court in *Steinmetz v. Al n*, 192 U. S. 543.

in which the requirement of the Examiner that the applicant divide his application was held to be "final and appealable." This Court there said (page 556):

"True, a distinction can be made between his ruling and one on the merits, if we regard the merits to mean invention, novelty or the like. But in what situation would an applicant for a patent be? If he yield to the rule he gives up his right of joinder. If he does not yield he will not be heard at all, and may subsequently be regarded as having abandoned his application. Section 4894, Rev. Stat. A ruling having such effect must be considered as final and appealable."

The Examiner's holding in *Steinmetz v. Allen* did not conclude the Patent Office prosecution. It did not in petitioner's case. In each case the holding raises a bar to the applicant getting the patent to which he feels himself entitled and so is "final and appealable."

Also unfortunate for the "policy" and for the decision below are the forcible statements made by this Court in *United States v. Duell*, 172 U. S. 576, in which it was held that Congress could provide for judicial interference with an action of the Patent Office and that the power to do so could not be successfully questioned as being an encroachment upon the judicial department. This Court said:

"Since, under the Constitution, Congress has power 'to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries,' and to make all laws which shall be necessary and proper for carrying that expressed power into execution, it follows that Congress may provide such instrumentalities in respect of securing to inventors the exclusive right to their discoveries as in its judgment will be best calculated to effect that object."

" . . . The nature of the thing to be done being judicial, Congress had power to provide for judicial

interference through a special tribunal, *United States v. Coc*, 155 U. S. 76; and a *fortiori* existing courts of competent jurisdiction might be availed of."

The "policy" and the decision are based upon a fundamental misconception that the prosecution before the Patent Office must be complete before the court can have jurisdiction. The Statute giving the district court jurisdiction gives direct recognition to the fact that subsequent Patent Office prosecution may occur when it states:

"And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication *and otherwise complying with the requirements of law*". (Section 4915 R. S., (Appendix, p. 20). (Italics supplied).

Further prosecution in the Patent Office is possible and actually probable in every case arising under Section 4915 R. S. Related statutes and the Rules of Practice in the United States Patent Office make subsequent prosecution a definite likelihood in every case.

The decision below is vulnerable to the criticism that it renders the right provided by Revised Statute 4915 a sterile, hollow shell. A suit properly brought could be rendered improper merely by the Commissioner stating in his answer that should the complainant-applicant prevail subsequent proceedings, newly recognized, would be necessary in the Patent Office. As the alternate right to appeal under Section 4911 R. S. expires in forty days (Appendix, pp. 19, 31, 32) after the final decision in the Patent Office that remedy would have been lost, probably before the bill was filed and certainly before the answer. The applicant's application would be lost, the district court ruling that it had no jurisdiction, and with it the applicant's right to a patent. No one would dare to bring suit under Section 4915 R. S.

It is clear that Section 4915 R. S. expressly provides for relief in two types of cases, ex parte and inter parte. The wording of the Statute supports this statement, as does the history of the equitable remedy. To require, as does the decision below, that an interference be contested before one of the parties has established his right to be a party to the interference, is clearly inconsistent with orderly procedure and places an unnecessary burden upon the Patent Office, upon all applicants and upon interfering patentees. To require, in order to vest jurisdiction in the district court under Section 4915 R. S., that the patent be refused not only ex parte, that is, by the Board of Appeals, but also inter partes, that is, by the board of interference examiners, is to refuse to accept the clear meaning of the language of the Statute and is also a refusal to give weight to the practical aspects of the situation; to wit, that an application is never simultaneously before the Board of Appeals and the board of interference examiners.

The requirement of the decision below that Patent Office prosecution be completed before the 4915 action be brought makes it possible for the Examiner to deprive the applicant of his right ever to contest his right to a patent except on a single, narrow claim. The Examiner could accomplish this by twice rejecting all of the claims except the narrowest upon which final decision would be delayed. Section 4909 R. S. provides an appeal when "any of the claims \* \* \* have been twice rejected." Applicant's right to the narrowest would not have been determined and, as further prosecution would be required to make the determination, an action under Section 4915 R. S. could not properly be brought under the decision below and the applicant would be forced to rely upon the appeal provided by Section 4911 R. S. Upon the return of the case to the Patent Office the applicant's right

to the remaining narrow claim would be determined and, from an adverse holding upon this narrow claim, applicant would have the right to bring a 4915 action under the decision below. If the rule of *Chase v. Coe*, 122 F. (2d) 198, App. D. C., (1941) is applied, then even the right to contest this narrow claim by a 4915 action would be lost, the case having once been the subject matter of an appeal under 4911 R. S.

It was obvious, however, that the equitable remedy would not have been available to applicant when the determination of his right to the important phases of the invention was at stake and, instead, would have been restricted to the determination of his right to the narrowest of the claims. It is difficult to believe that Congress had such an intention in enacting Section 4915 R. S. The problem confronting petitioner in the present case is no different from that confronting applicant in the hypothetical case proposed. (R. 113).

This Court said, in the case of *Armstrong Paint and Varnish Works v. Nu-Enamel Corporation et al*, 305 U. S. 315, 59 S. Ct. 191, 200:

"This Court has had several occasions within the last few years to construe statutes in which conflicts between reasonable intention and literal meaning occurred. We have refused to nullify statutes, however hard or unexpected the particular effect, where unambiguous language called for a logical and sensible result. Any other course would be properly condemned as judicial legislation. However, to construe statutes so as to avoid results glaringly absurd, has long been a judicial function. Where, as here, the language is susceptible of a construction which preserves the usefulness of the section, the judicial duty rests upon this Court to give expression to the intendment of the law."

The only point of tangency between the Patent Office and the Constitutional courts comprises the suit in equity provided by Section 4915 R. S. If this remedy is destroyed, and the decision of the court below effectively destroys it, there will not hereafter be any opportunity for Constitutional courts to bring their views and opinions to bear directly upon the Patent Office and its views of substantive and adjective patent law. The appeal provided by Section 4911 R. S. to the Court of Customs and Patent Appeals cannot be appealed to this court, (*Postum v. California Fig Nut Co.*, 272 U. S. 693 (1927); *Baldwin v. Howard*, 256 U. S. 35, 44 S. Ct. 508, (1921)) the Court of Customs and Patent Appeals being an administrative tribunal.

The desirability of influencing the Patent Office and its practices by contact with courts of general law is believed to be very clear. Courts of limited jurisdiction tend to become narrow and technical in their views and holdings and if the 4915 remedy is eliminated, the tempering influence which has been so beneficial in the past will no longer be present.

Section 4915 R. S. and its predecessors giving the same remedy in substantially the same language have been interpreted in accordance with petitioner's contentions, as indicated by the unvaried practice, since 1839. No case supporting the position of the court below was noted. In *Dismuke v. United States*, 297 U. S. 167, 56 Sup. Ct. 400, 404 the Court stated relative to a statutory interpretation which had stood for a period of fifteen years:

"A construction of such long standing is not lightly to be overturned."

In short, the decision below comprises an undesirable departure entirely unwarranted in the absence of compell-

ing necessity which, if it exists, remains entirely unindicated. For this and other reasons set forth herein this Court is respectfully urged to reverse the decision below and to render such other relief as is deemed proper.

Respectfully submitted,

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APPENDIX.



## APPENDIX.

### The Patent Act of 1836.

SECTION 7. *And be it further enacted*, That on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor, or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification, to embrace only that part of the invention or discovery which is new. In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars.

part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the treasurer for paying back to the said applicant the said sum of twenty dollars. But if the applicant in such case shall persist in his claims for a patent, with or without any alteration in his specification, he shall be required to make oath or affirmation anew, in manner as aforesaid. And if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing of the opinion and decision of the Commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the Commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the Commissioner to furnish to the board of examiners such information as he may possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or the majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby.

in the further proceedings to be had on such application: *Provided however*, That before a board shall be instituted in any such case, the applicant shall pay to the credit of the treasury, as provided in the ninth section of this act, the sum of twenty-five dollars, and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding ten dollars, to be determined and paid by the Commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

SECTION 8. *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be; and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision; on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which or whether either of the applicants is entitled to receive a patent as prayed for. But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings. And whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not however exceeding six months prior to

the actual issuing of the patent; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the office until he shall furnish the model and the patent to be issued, not exceeding the term of one year, the applicant being entitled to notice of interfering applications.

SECTION 16: *And be it further enacted*, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided however*, That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from, or under them subsequent to the rendition of such judgment.

**The Patent Act of 1839.**

SECTION 10. *And be it further enacted*, That the provisions of the sixteenth section of the before-recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by the applicant; whether the final decision shall be in his favor or otherwise.

SECTION 11. *And be it further enacted*, That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing, whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the said judge all the original papers

and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal, to which the revision shall be confined. And at the request of any party interested, or at the desire of the judge, the Commissioner and the examiners in the Patent Office may be examined under oath, in explanation of the principles of the machine or other thing for which a patent, in such case is prayed for. And it shall be the duty of said judge, after a hearing of any such case, to return all the papers to the Commissioner, with a certificate of his proceedings and decision, which shall be entered of record in the Patent Office; and such decision, so certified, shall govern the further proceedings of the Commissioner in such case: *Provided however*, That no opinion or decision of the judge in any such case shall preclude any person interested in favor or against the validity of any patent, which has been or may, hereafter be granted from the right to contest the same in any judicial court, in any action in which its validity may come in question.

• **The Consolidated Patent Act of 1870.**

SECTION 41. *And be it further enacted*, That whenever, on examination, any claim for a patent is rejected for any reason whatever, the commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant shall persist in his claim for a patent, with or without altering his specifications, the commissioner shall order a re-examination of the case.

SECTION 42. *And be it further enacted*, That whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice

thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who shall be adjudged the prior inventor, unless the adverse party shall appeal from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the commissioner shall prescribe.

SECTION 46. *And be it further enacted*, That every applicant for a patent or the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interference[s], in such case to the board of examiners-in-chief, having once paid the fee for such appeal provided by law.

SECTION 47. *And be it further enacted*, That if such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the duty required by law, appeal to the commissioner in person.

SECTION 48. *And be it further enacted*, That if such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

SECTION 52. *And be it further enacted*, That whenever a patent on application is refused, for any reason whatever, either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner,

the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

### **The Revised Statutes in 1874.**

SECTION 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal.

SECTION 4910. If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person.

SECTION 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

SECTION 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent-Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

### **The Judiciary Act of 1893.**

SECTION 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the Court of Appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals.

APPROVED February 9, 1893.

### **The Revised Statutes After the Patent Act of March 2, 1927.**

SEC. 4509. Every applicant for a patent or for the re-issue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the Board of Appeals; having once paid the fee for such appeal.

*Act of Feb. 9, 1893:*

*Be it enacted, etc.,* That there shall be, and there is hereby, established in the District of Columbia a court, to be known as the Court of Appeals of the District of Columbia, which shall consist of one chief justice and two associate justices, who shall be appointed by the President, by and with the advice and consent of the Senate, and shall hold office during good behavior.

SEC. 4911. If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the Court of Appeals of the District of Columbia, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the Board of Appeals, he may appeal to the Court of Appeals of the District of Columbia, provided that such appeal shall be dismissed if any adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case. If the appellant shall file such bill within said thirty days and shall file due proof thereof with the Commissioner of Patents, the issue of a patent to the party awarded priority by said Board of Appeals shall be withheld pending the final determination of said proceeding under said section 4915.

*Act of Mar. 2, 1927, 44 Stat. L., 1335:*

SEC. 15. That this act shall take effect two months after its approval; but it shall not affect appeals then pending and heard before the examiners in chief or pending before

the Commissioner of Patents or in the Court of Appeals of the District of Columbia, and that in all cases in which the time for appeal from a decision of the examiners in chief or of the Commissioner of Patents or for amendment or renewal of application had not expired at the time this act takes effect, appeals and other proceedings may be taken under the statutes in force at the time of approval of this act as if such statutes had not been amended or repealed.

SEC. 4915. Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the Board of Appeals to the Court of Appeals of the District of Columbia, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right

of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

*Act of Mar. 3, 1927, 44 Stat. L., 1394:*

And upon the filing of a bill in the Supreme Court of the District of Columbia wherein remedy is sought under section 4915 or section 4918 of the Revised Statutes, without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in this section: *Provided*, That writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

**The Revised Statutes After the Patent Act of March 2, 1929.**

SEC. 4909. (U. S. C., title 35, sec. 57.) Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the Board of Appeals; having once paid the fee for such appeal.

*Act of Mar. 3, 1911 (Judicial Code):*

SEC. 188. (U. S. C., title 28, sec. 301.) There shall be a United States Court of Customs and Patent Appeals, which shall consist of a presiding judge and four associate judges, each of whom shall be appointed by the President by and with the advice and consent of the Senate, and shall receive a salary of twelve thousand five hundred dollars a year. The

presiding judge shall be so designated in the order of appointment and in the commission issued to him by the President; and the associate judges shall have precedence according to the date of their commissions. Any three members of said court shall constitute a quorum, and the concurrence of three members shall be necessary to any decision thereof. In case of a vacancy or of the temporary inability, or disqualification for any reason, of one or two of the judges of said court, the President may, upon the request of the presiding judge of said court, designate any qualified United States circuit or district judge or judges to act in his or their place; and such circuit or district judges shall be duly qualified to so act.

*Act of May, 2, 1929, 45 Stat. L. 1476:*

SEC. 2. (U. S. C., title 28, sec. 309a.) (a) The jurisdiction vested prior to April 1, 1929, in the Court of Appeals of the District of Columbia in respect of appeals from the Patent Office in patent and trade-mark cases is vested in the United States Court of Customs and Patent Appeals.

(d) Nothing contained in this section shall be construed as affecting in any way the jurisdiction of the Court of Appeals of the District of Columbia in equity cases.

*Revised Statutes, Title LX:*

SEC. 4911. (U. S. C., title 35, sec. 59a.) If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. (U. S. C., title 35, sec. 63.) If any party to an interference is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any

adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes (U. S. C., title 35, sec. 60), file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case. If the appellant shall file such bill within said thirty days and shall file due proof thereof with the Commissioner of Patents, the issue of a patent to the party awarded priority by said Board of Appeals shall be withheld pending the final determination of said proceeding under said section 4915.

*Act of Mar. 2, 1927, 44 Stat. L. 1335:*

SEC. 15. That this act shall take effect two months after its approval; but it shall not affect appeals then pending and heard before the examiners in chief or pending before the Commissioner of Patents or in the Court of Appeals of the District of Columbia, and that in all cases in which the time for appeal from a decision of the examiners in chief or of the Commissioner of Patents, or for amendment or renewal of application had not expired at the time this act takes effect, appeals and other proceedings may be taken under the statutes in force at the time of approval of this act as if such statutes had not been amended or repealed.

SEC. 4915 (U. S. C., title 35, sec. 63.) Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the Board of Appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought

under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant; shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

*Act of March 3, 1927, 44 Stat. L. 1394: (U. S. C., title 35, sec. 72a.)*

And upon the filing of a bill in the Supreme Court of the District of Columbia wherein remedy is sought under section 4915 or section 4918 of the Revised Statutes, (U. S. C., title 35, sec. 63 or sec. 66) without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall unless the

adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in this section (sec. 113 of title 28, U. S. C.): *Provided*, That writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

### The Revised Statutes in 1941 and Today.

SEC. 481. R. S. (U. S. C., title 35, sec. 6.) The Commissioner of Patents, under the direction of the Secretary of Commerce, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

SEC. 4886. R. S. (U. S. C., title 35, sec. 31.) Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. [The period is *two years* instead of "one year" where the application was filed prior to Aug. 5, 1940. See Sec. 2 of Act of Aug. 5, 1939; *infra*.]

*Act of Aug. 5, 1939, 53 Stat. 1212:*

SEC. 2. This Act [amending sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 62, 69, and 73) by changing "two years" to *one year*] shall take effect one year after its approval and shall apply to all applications for patent filed after it takes effect and to all patents granted on such applications; *Provided, however,* That all applications for patents filed prior to the time this Act takes effect and all patents granted on such applications are to be governed by the statutes in force at the time of approval of this Act as if such statutes had not been amended.

ii.

SEC. 4904. R. S. (U. S. C., title 35; sec. 52). Whenever an application is made for a patent which, in the opinion of the Commission, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor. [As to interferences declared prior to Oct. 5, 1939, see Sec. 5 of Act of Aug. 5, 1939, *infra*.]

*Act of Aug. 5, 1939, 53 Stat. 1212:*

SEC. 5. This Act [amending sections 4904, 4909, 4911, and 4915 of the Revised Statutes (U. S. C., title 35, secs. 52, 57, 59a, and 63)] shall take effect two months after its approval; but it shall not affect interferences then pending, which may be heard and decided and appeals and other proceedings taken under the statutes in force at the time of approval of this Act as if such statutes had not been amended.

SEC. 4909. R. S. (U. S. C., title 35, sec. 57.) Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal. [As to interferences declared prior to Oct. 5, 1939, see Sec. 5 of Act of Aug. 5, 1939, printed after R. S. Sec. 4904, *ante*.]

*Act of Mar. 2, 1929, 45 Stat. 1476:*

SEC. 2. (U. S. C., title 28, sec. 309a.) (a) The jurisdiction vested prior to April 1, 1929, in the Court of Appeals of the District of Columbia in respect of appeals from the Patent Office in patent and trade-mark cases is vested in the United States Court of Customs and Patent Appeals.

(d) Nothing contained in this section shall be construed as affecting in any way the jurisdiction of the U. S. Court of Appeals for the District of Columbia in equity cases.

SEC. 3. (U. S. C., title 28, sec. 312.) The opinion of the Court of Customs and Patent Appeals in every case on appeal from the decision of the Patent Office shall be rendered in writing, and shall be filed in such case as part of the record thereof, and a certified copy of said opinion shall be sent to the Commissioner of Patents and shall be entered of record in the Patent Office.

SEC. 4911. R. S. (U. S. C., title 35, sec. 59a.) If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. (U. S. C., title 35, sec. 63.) If any party to an interference is dissatisfied with the decision of the board of interference examiners he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes. (U. S. C., title 35, sec. 60), file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case [As to interferences declared prior to Oct. 5, 1939, see sec. 5 of Act of Aug. 5, 1939, printed after R. S. sec. 4904, *ante*.]

SEC. 4914. R. S. (U. S. C., title 35, sec. 62.) The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no

opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

SEC. 4915. R. S. (U. S. C., title 35, sec. 63.) Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office

when admitted shall have the same force and effect as if originally taken and produced in the suit. [As to interferences declared prior to Oct. 5, 1939 see Sec. 5 of Act of Aug. 5, 1939, printed after R. S. Sec. 4904, *ante*.]

*Act of March 3, 1927, 44 Stat. 1394 (U. S. C., title 35, sec. 720):*

And upon the filing of a bill in the District Court of the United States for the District of Columbia wherein remedy is sought under section 4915 or section 4918 of the Revised Statutes (U. S. C., title 35, sec. 63 or sec. 66), without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in this section (sec. 113 of title 28 U. S. C.): *Provided*, That writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

Sec. 4918. R. S. (U. S. C., title 35, sec. 66.) Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either or both the patents void in whole or in part upon any ground, or inoperative, or invalid in

any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

**Rules of Practice in the United States Patent Office:**

63. (d) Applications which appear to interfere with other applications previously considered and found to be allowable, or which it is demanded shall be placed in interference with an unexpired patent or patents.

Where an applicant copies claims from a patent and the examiner is of the opinion that he can make none of these claims, he should state in his action why he can not make the claims and set a time limit, not less than twenty days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit should be set for appeal. Failure to respond or appeal, as the case may be, within the time fixed, will in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed. (See rule 94.)

93. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject-matter is claimed in a plurality of applications or in an application and a patent. In order to ascertain whether any question of priority arises the Commissioner may call upon any junior applicant to state in writing under oath the date and the character of the earliest fact or act, susceptible

of proof, which will be relied upon to establish conception of the invention under consideration. The sworn statement filed in compliance with this rule will be retained by the Patent Office separate from the application file and if an interference is declared will be opened simultaneously with the preliminary statement of the party filing the same. In case the junior applicant makes no reply within the time specified, not less than twenty days, the Commissioner will proceed upon the assumption that the said date is the date of the oath attached to the application. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor.

94. Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same invention which are allowable in the application of each party, and interferences will also be declared between applications for patent, or for reissue, and unexpired original or issued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved: *Provided*, That where the filing date of any applicant is subsequent to the filing date of any patentee, the applicant shall file an affidavit that he made the invention in controversy in this country before the filing date of the patentee; and when required the applicant shall file an affidavit setting forth facts showing that he completed the invention in controversy, in this country, before the filing date of the patentee.

Where claims are copied from a patent and the examiner is of the opinion that the applicant can make only some of the claims so copied, he shall notify the applicant to that effect, state why he is of the opinion he cannot make the other claims and state further that the interference will be promptly declared and that the applicant may proceed under rule 109, if he further desires to contest his right to make the claims not included in the declaration of the interference.

Where an applicant presents a claim copied or substantially copied from a patent, he must at the time he presents the claim identify the patent, give the number of the patented claim, and specifically apply the terms of the copied claim to his own disclosure.

No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application unless such amendment is filed within one year from the date on which said patent was granted.

Parties owning applications or patents which contain conflicting claims will be required to show cause why these claims shall not be eliminated from all but one of the applications or patents of common ownership.

95. Before the declaration of interference it must be determined that there is common patentable subject matter in the cases of the respective parties. The issue must be clearly defined and be patentable to the respective parties, subject to the determination of the question of priority.

In case the subject matter in controversy has been patented to one of the parties but is deemed by the examiner not to be patentable to an applicant, he shall call the case to the attention of the Commissioner.

96. Whenever the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner shall suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner shall send copies of the letter suggesting claims to the applicant and to the assignee, as well as to the attorney or agent of record in each case. The parties to whom the claims are suggested will be required to make those claims within a specified time in order that an interference may be declared. Upon the failure of any applicant to make any claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by the claim unless the time be extended upon a proper showing. After judgment of priority the application of any party may be held for revision and restriction, subject to interference with other applications.

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney or agent, the examiner shall notify each of said principal parties and also the attorney or agent of this fact.

109. An applicant involved in an interference may, within a time fixed by the examiner of interferences not less than thirty days after the preliminary statements (referred to in rule 110) of the parties have been received and approved, or if a motion to dissolve the interference has been brought by another party, within thirty days from the filing thereof, on motion duly made as provided by rule 153, file an amendment to his application containing any claims which in his opinion should be made the basis of interference between himself and any of the other parties.

Such motion must be accompanied by the proposed amendment, and when in proper form will be set by the examiner of interferences for hearing before the primary examiner. Where a party opposes the admission of such an amendment in view of prior patents or publications, full notice of such patents or publications, applying them to the proposed counts, must be given to all parties at least twenty days prior to the date of hearing. On the admission of such amendment and the adoption of the claims by the other parties within a time specified the primary examiner shall redeclare the interference or shall declare such other interferences as may be necessary to include the said claims. New preliminary statements will be received as to the added claims, but motions for dissolution with regard thereto will not be considered where the questions raised could have been disposed of in connection with the admission of the claims. Amendments to the specification will not be received during the pendency of the interference without the consent of the Commissioner, except as provided herein and in rule 106.

Any party to an interference may bring a motion to put in interference any claims already in his application or patent which should be made the basis of interference between himself and any of the other parties. Any party to an interference may bring a motion to add or substitute any other application owned by him, as to the existing issue, or to include an application or a patent owned by him, as to claims which should be made the basis of interference between himself and any of the other parties. Such motions are subject to the same conditions and the procedure in connection therewith is the same, so far as applicable, as hereinabove set forth for motions to amend.

111. The preliminary statements shall not be opened to the inspection of the opposing parties until all motions to dissolve under rule 122 and all motions to amend under rule 109 and interlocutory appeals respecting the same have been finally disposed of or the time for filing such motions has expired without such a motion having been filed, and the case is in condition for taking of testimony.

A junior party who fails to file a preliminary statement or a party who alleges no date in his preliminary statement earlier than the filing date of the application or applications of another party shall not have access to the preliminary statement of said party.

If the interference be terminated by dissolution, the preliminary statements will remain sealed.

116. The parties to an interference will be presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing same; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

The termination of the interference by dissolution under rule 122 without an award of priority shall not disturb this presumption, and a party enjoying the status of a senior party with respect to any subject-matter of his application shall not be deprived of any claim to such subject-matter solely on the ground that such claim was not added to the interference by amendment under rule 109.

122. Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) denying the patentability

of an applicant's claim, or (3) denying his right to make the claim, or (4) if the interference involves a design patent or an application, alleging that there is no interference in fact and also motions to shift the burden of proof, should contain a full statement of the ground relied upon and should, if possible, be made within the time fixed by the examiner of interferences, not less than thirty days, after the statements of the parties have been received and approved. Such motions and all motions of a similar character, if in the opinion of the examiner of interferences they be in proper form, will be heard and determined by the primary examiner, due notice of the day of hearing being given by the office to all parties. If in the opinion of the examiner of interferences the motion be not in proper form, or if it be not brought within the time specified and no satisfactory reason be given for the delay, it will not be considered and the parties will be so notified.

At a hearing on a motion to dissolve an interference between an application and a patent, the prior art of record in the patent file shall be referred to for the purpose of construing the issue. The matter raised on a motion to shift the burden of proof may be reviewed at final hearing.

123. Setting a motion brought under the provisions of rule 109 or of rule 122 for hearing will act as a stay of proceedings pending the determination of the motion. To effect a stay of proceedings in other cases, motion should be made before the tribunal having jurisdiction of the interference, who will, sufficient grounds appearing therefor, order a suspension of the interference pending the determination of such motion.

124. No appeal will be permitted from a decision rendered on a motion brought under the provisions of rules 109 and 122.

Appeals may be taken directly to the Commissioner from decisions on such other motions as, in his judgment, should be appealable.

126. The board of interference examiners may, either before or in their decision on the question of priority, direct the attention of the Commissioner to any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (rule 122), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed. From the decision of the examiner appeal may be taken as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the Commissioner.

130. Where the patentability of a claim to an opponent is material to the right of a party to a patent, said party may urge the nonpatentability of the claim to his opponent as a basis for the decision upon priority of invention. A party shall not be entitled to raise this question, however, unless he has duly presented and prosecuted a motion under

rule 122 for dissolution upon this ground or shows good reason why such a motion was not presented and prosecuted.

At final hearing between an application and a patent the prior art of record in the patent file shall be referred to for the purpose of construing the issue.

133. Every applicant for a patent, any of the claims of whose application have been twice rejected for the same reasons, upon grounds involving merits of the invention, such as lack of invention, novelty, or utility, or on the ground of abandonment, public use or sale, inoperativeness of invention, aggregation of elements, incomplete combination of elements, or, when amended, for want of identity with the invention originally disclosed, or because the amendment involves a departure from the invention originally presented; and every applicant who has been twice required to divide his application, and every applicant for the reissue of a patent whose claims have been twice rejected for any of the reasons above enumerated, or on the ground that the original patent is not operative or invalid, or if so inoperative or invalid that the errors which rendered it so did not rise from inadvertence, accident, or mistake, may, upon payment of a fee of \$15, appeal from the decision of the primary examiner to the board of appeals. The appeal must set forth in writing the points of the decision upon which it is taken, and must be signed by the applicant or his duly authorized attorney or agent.

141. After decision by an appellate tribunal the case shall be remanded at once to the primary examiner, subject to the applicant's right of appeal, for such action as will carry into effect the decision, or for such further action as the applicant is entitled to demand.

449. When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within forty days, exclusive of Sundays and legal holidays in the District of Columbia but including Saturday half holidays, from the date of the decision appealed from, his reasons of appeal specifically set forth in writing; *Provided*, however, that if a petition for rehearing or reconsideration is filed within 20 calendar days after said decision, the notice of appeal may be given and the reasons of appeal filed within 15 calendar days after action on the petition. No petition for rehearing or reconsideration filed more than 20 calendar days after such decision, nor any proceedings on such petition, shall operate to extend the period of 40 days hereinabove provided for appeal.

If an applicant in an *ex parte* case appeals to the U. S. Court of Customs and Patent Appeals he waives his right to proceed under section 4915 R. S. (U. S. C., title 35, sec. 63).

If a defeated party to an interference proceeding appeals to the U. S. Court of Customs and Patent Appeals, and any adverse party to the interference shall, within twenty days after the appellant shall have filed notice of the appeal to the court, file notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 4915 R. S., certified copies of the foregoing papers will be transmitted to the U. S. Court of Customs and Patent Appeals for such action as may be necessary. The notice of election must be served as provided in rule 154 (b). [See rule 153 (a).]

From adverse decisions by the board of appeals in *ex parte* cases and from decisions of the board of interference examiners, the appellant, if an applicant, has the option of proceeding under section 4915 R. S. instead of appealing directly to the U. S. Court of Customs and Patent Appeals.

### **Rules of Civil Procedure:**

8(d) EFFECT OF FAILURE TO DENY. Averments in a pleading to which a responsive pleading is required, other than those as to the amount of damage, are admitted when not denied in the responsive pleading. Averments in a pleading to which no responsive pleading is required or permitted shall be taken as denied or avoided.

### **Rules of U. S. Court of Customs and Patent Appeal: Rule XXV.**

1. Any party desiring to appeal to this court from a decision of the Board of Appeals, Board of Interference Examiners or the Commissioner of Patents shall file in the clerk's office a petition, addressed to the court, in which he shall briefly set forth and show that he has complied with the requirements of section 4912 and 4913 of the Revised Statutes of the United States to entitle him to an appeal, and praying that his appeal may be heard upon and for the reasons assigned therefor to the commissioner. Said reasons for appeal, having been filed with the Commissioner of Patents and made a part of the record, shall not be repeated in the petition of appeal. Said petition

of appeal and a certified copy of the record in the proceeding shall be filed in this court and the case duly docketed within 40 days (exclusive of Sundays and legal holidays) from the date upon which said reasons for appeal were filed with the Commissioner of Patents: *Provided*, That the commissioner may for special and sufficient cause extend such time to some definite and fixed date: *Provided, further*, That in inter partes cases appellant shall, at the time of filing said petition of appeal in this court, or within 10 days thereafter, serve a copy thereof upon appellee or his counsel.

If said petition of appeal and copy of said record shall not be filed within said period of 40 days, unless such time be extended by the commissioner as heretofore provided, the commissioner, upon such facts being brought to his attention by motion of the appellee in inter partes cases, duly served upon the appellant or his attorney, and upon his own motion in ex parte appeals, may take such further proceedings in the case as may be necessary to dispose of the same as though no notice of appeal had ever been given. *Provided, however*, That if any adverse party in an interference case shall, within twenty days after appellant shall have filed notice of appeal to this court, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes, certified copies of the notice of appeal and the notice of election shall be transmitted to this court by the Commissioner of Patents for appropriate action according to law.

2. All certified copies of papers and evidence on appeal from the decision of the final appellate tribunal of the Patent Office shall be received by the clerk of this court.

and the cases, by titling and number, shall be placed on a separate docket to be designated as the "Patent appeal docket." The clerk shall, under this titling of the case on the docket, make brief entries of all papers filed and of all proceedings had in the case.

